Office-Supreme Court, U.S.
FILED
JUL 14 1965
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

IN THE MATTER
OF THE
APPLICATION OF FREDERICK C. FOSTER,
Petitioner

APPENDIX TO PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS

EDWARD S. IRONS
1000 Connecticut Avenue, N. W.
Washington, D. C. 20036
Attorney for Petitioner

Of Counsel:

STANLEY M. CLARK
c/o The Firestone Tire & Rubber Company
1200 Firestone Parkway
Akron, Ohio

MARY HELEN SEARS
1000 Connecticut Avenue, N. W.
Washington, D. C. 20036

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

INDEX

	Page
Constitutional and Statutory Provisions Involved ..	1a
Article I, Section 8, clause 8 of the Constitution ..	1a
35 U.S.C. 6	2a
35 U.S.C. 102(a) and (b)	2a
35 U.S.C. 103	2a
35 U.S.C. 132	3a
35 U.S.C. 144	3a
35 U.S.C. 282	4a
R.S. 4886, as amended	4a
In the Matter of the Application of Foster	5a
Almond, Judge	5a
Worley, Chief Judge, concurring	26a
Rich, Judge, concurring	28a
Smith, Judge, dissenting	28a
Letter of George E. Hutchinson, Clerk, Court of Customs and Patent Appeals, dated July 1, 1965 (rehearing denied; enforcement of decree stayed)	42a
In the Matter of the Application of Folkers	43a
Martin, Judge	43a
Smith, Judge dissenting	45a
In the Matter of the Application of Hassler	49a
Martin, Judge	49a
Smith, Judge, concurring	62a
Patent Office Board of Appeals Decisions in *Ex parte Foster*	65a
Original decision dated May 29, 1962	65a
Decision on Reconsideration dated September 17, 1962	71a

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No.

IN THE MATTER
OF THE
APPLICATION OF FREDERICK C. FOSTER,
Petitioner

APPENDIX TO PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS

Constitutional and Statutory Provisions Involved

Article I, Section 8, clause 8, of the Constitution of the United States provides:

"The Congress shall have Power

* * * * *

"To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;"

35 U.S.C. 6 provides:

"§ 6. Duties of Commissioner

"The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trade-marks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

35 U.S.C. 102(a) and (b) provide:

"§ 102. Conditions for patentability; novelty and loss of right to patent

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, . . ."

35 U.S.C. 103 provides:

"§ 103. Conditions for patentability; non-obvious subject matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would

have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

35 U.S.C. 132 provides:

"§ 132. Notice of rejection; reexamination

"Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention."

35 U.S.C. 144 provides:

"§ 144. Decision on appeal

"The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case."

35 U.S.C. 282 provides:

"§ 282. Presumption of validity; defenses

* * * * *

"The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

* * * * *

"(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability, . . ."

R.S. 4886, as amended, provided:

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

In the Matter of the Application of Foster

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

No. 7106 Decided Apr. 15, 1965

Appeal from the United States Patent Office

ALMOND, Judge.

This is an appeal from the decision of the Board of Appeals affirming the rejection of the claims in appellant's patent application.[1]

The invention relates to elastomeric synthetic polymers said to combine the desirable properties of natural Hevea rubber and the presently employed synthetic rubbers. These properties are described in the specification:

> "Hevea natural rubber is characterized by excellent tack, especially after milling; thus being ideal for tire building operations. Hevea produces vulcanizates having excellent resilience and low hysteresis properties, high tensile strength, and good flexibility at low temperatures. Gum vulcanizates formed from Hevea also possess high tensile strength. Hevea natural rubber is characterized by a crystallinity of at least about 40% and displays a crystalline X-ray diffraction pattern when stretched."

> "Heretofore, the synthetic rubbers, in comparison with Hevea rubber, have exhibited low tack and no crys-

[1] Serial No. 605,440, filed August 21, 1956, for "Butadiene Polymers and Copolymers Thereof."

talline properties while their vulcanizates have been characterized by undesirably low tensile strengths and resilience, and undesirably high hysteresis. The synthetic rubbers, particularly the butadiene/styrene copolymer (GR-S), have been greatly superior to natural rubber in resisting crack initiation in service but have been markedly inferior to Hevea in resisting crack and cut growth. The undesirably high hysteresis of the synthetic rubbery polymers has prevented their use in any substantial quantity in the production of such articles as the large tires employed on trucks, buses, and large off-the-road vehicles.''

Infrared analysis of Hevea rubber has shown that the polymer consists of about 97.8% cis-1, 4-structure. That is, the units of the rubber molecules are connected to each other in 1, 4-addition to produce a linear chain with the spatial arrangement of the units in what is called the cis, as opposed to the trans, stereospecific configuration.[2]

---

[2] The various polymer configurations which may result from the polymerization of conjugated diene are explained in Whitby, Synthetic Rubber, at 289, 290 (1954):

''In a butadiene polymer the two units that may occur in the chain are the 1, 4-unit (I) and the 1, 2-unit (II). When a monosubstituted butadiene such as isoprene is polymerized the possibilities are greater, for the 1, 4-units may be united 'head-to-head and tail-to-tail' (III) and head-to-tail (IV), and, further, addition may occur 1, 2 at the substituted double bond to produce the 1, 2-unit (V) or 3, 4 at the unsubstituted double bond to produce the 3, 4 unit (VI).''

''It should be noted that structures I, III, and IV are capable of existing in cis and trans configurations at each double union, and that structure [sic] II, V, and VI have asymmetric carbon atoms which make optical isomerism possible.''

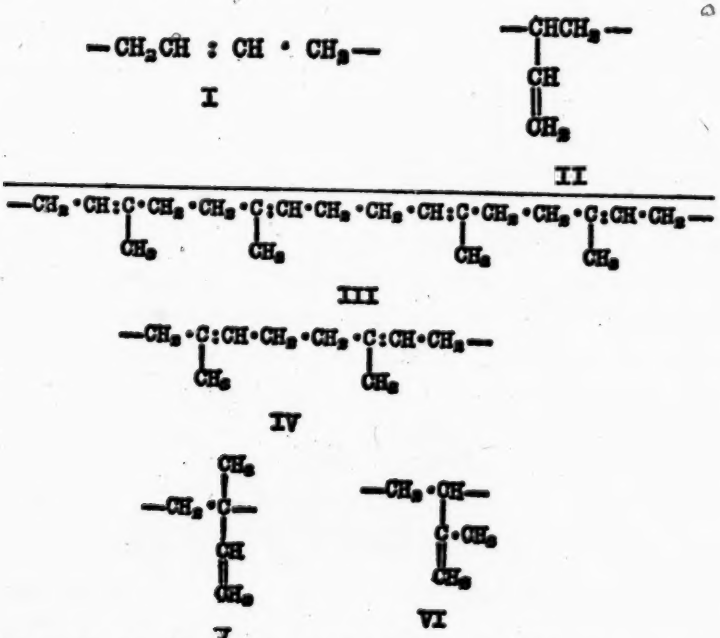
Footnote 2 continued on page 7a.

In contrast, the specification notes that "The butadiene portion of a typical GRS emulsion copolymer contains about 64% trans-1,4-structure, 18% cis-1,4-structure and 18% 1,2-structure."

By increasing the amount of cis-1,4-structure butadiene, the properties of the synthetic rubber are greatly improved.

All of the claims are drawn to synthetic polymer products, although some contain limitations as to how the polymer is formed (e.g., "by solution polymerization"). A wide variety of combinations is claimed, but broadly three groups emerge. Some of the claims[3] specify a certain amount of cis-1,4-structure polymer, as, for example, claim 12, which reads:

> "A synthetic polymer selected from the group consisting of rubbery homopolymers of butadiene-1,3 and rubbery copolymers of butadiene-1,3 and styrene; said



I II III IV V VI

[3] Claims 12, 13, 17, 18, 29, 30, 32, 33, 34, 35, 36, 39 and 40.

synthetic polymer being characterized by a cis 1,4-structure of at least 23% and a 1,2-structure not in excess of 15% of the polymeric butadiene present in the polymer."

Other claims[4] merely specify that the head-to-tail structure be present (a type of 1,4-structure without denomination as cis- or trans-). Representative of these is claim 25:

"A synthetic polymer selected from the group consisting of rubbery homopolymers of butadiene-1,3 and rubbery copolymers of butadiene-1,3 and styrene; said synthetic polymer being characterized in that at least 85 per cent of the butadiene monomer units thereof are joined in a head-to-tail relationship."

Finally, there is claim 28:

"Products comprising conjugated polyolefin hydrocarbon polymers and copolymers in which the conjugated polyolefin monomer units are present in 1,4 additional polymer structure."

Although the specification, the original claims, the decision of the board, the briefs on appeal, and the oral arguments stress the importance of the high percentage of cis-1,4-stereoconfiguration as contrasted with trans-1,4, and the low percentage of 1,2-structure in producing the results obtained (counsel for appellant characterized the invention as a "breakthrough"), we note that the second and third groups of claims outlined above are not limited to the cis-stereoconfiguration. Nevertheless, no issue was raised on whether the invention is properly defined without specifying the cis-configuration, our attention being directed to other issues raised in the 415 pages of printed record.

---

[4] Claims 22, 23, 25 and 26.

The examiner and the Board of Appeals rejected all of the claims on the basis of the Binder reference. The record indicates that Binder, an employee of appellant's assignee, wrote an article in the magazine "Industrial and Engineering Chemistry."[5] The article reports analyses of the miscrostructures of polybutadiene homopolymers and copolymers with styrene. The portions particularly relied upon by the Patent Office are:

1. Table V which lists polymer "39-1" as having 22.7% cis-1,4; 60.0% trans-1,4; and 17.3% 1,2 structures of butadiene. It is noted that the catalyst employed was a peroxide.

2. Conclusion: "The results of the analyses reported here show that while the amount of cis-1,4 addition increases with increasing temperature of polymerization, a polybutadiene containing 100% cis-1,4 or trans-1,4 addition cannot be made at any practical temperature."

It also should be noted that the Binder report at the outset states: "During the past 2 years, a large number of polybutadienes and butadiene-styrene copolymers have been prepared in these laboratories, in which various changes were made in the recipes with the object, mainly, of increasing the amount of cis-1,4 addition."

One of the issues presented is: What is the statutory basis of the rejection on prior art? Appellant contends it is 35 U.S.C. 103 and the solicitor contends it is both section 103 and section 102. Neither the examiner nor the board mentioned any statute section.

The examiner rejected the claims "as unpatentable over Binder" in the final rejection, the first office action printed in the record on appeal. Appellant submitted a number of papers which the examiner found failed "to place the case in condition for allowance." The examiner repeated the "unpatentable over Binder" rejection, but added in the

---

[5] Vol. 46, No. 8, pp. 1727-1730, August 1954.

same paragraph "The claimed polymer only differs in degree and not in kind from the prepared polymer of Binder and is *anticipated* by the disclosure of 100% cis 1,4 polybutadiene on page 1730 of the article." [Emphasis supplied.] Appellant responded that the word "anticipated" raised a new issue and a new rejection and sought to amend the application. The examiner refused to enter the amendment, but repeated the statement that "a polymer containing the claimed structure is anticipated by Binder." Appellant then petitioned to the Commissioner of Patents whose decision stated:

> "Under all the circumstances and in view of the facts now brought out in the petition, it is concluded that it would be advisable to enter the appellant's proposed claims 39 and 40 and to permit the examiner in his answer to the appeal to rely on the Binder patent [sic] either as an anticipation or as a basis for a rejection on lack of invention, or both, as he may see fit."

The examiner then wrote his answer which was divided into several headings. Under "The Reference," the examiner concluded with the statement:

> "Note that Binder does *not* say that 100 [sic] cis 1,4 polybutadiene *cannot* be made. Binder merely states that cis-1,4 polybutadiene cannot be made in the *particular emulsion systems* discussed at any practical temperature. Hence, the naming of 100% cis-1,4 polybutadiene by Binder is deemed to be a full disclosure of said polymer. In re Von Bramer et al., 542 O.G. 183, 53 USPQ 345."

Immediately below this, under "The Rejection," the examiner stated that the "claims 22, 23, 25, 26 and 28 which read upon a butadiene polymer characterized by possessing a 100% cis 1,4 or 100% trans 1,4 structure are deemed unpatentable over" Binder, with no mention of "anticipation."

It is appellant's contention that the words "unpatentable over" mean that the statutory basis is section 103 and the word "anticipated" indicates reliance on section 102(b). Since there was no *rejection* on the ground of "anticipation," appellant argues that the statutory basis must be section 103.

We agree that the language employed is confusing and that it is not clear what section of the statute is intended. On the other hand, we are not convinced that there is any "magic" to the particular words used or that they can only mean reliance on section 103. The words "unpatentable over" do not *necessarily* mean reliance on section 103 *alone*. The statements of the rejections are sufficient for us to consider the rejections on both sections 102(b) and 103.

Considering first the rejection on the ground that Binder contains a full disclosure, we note that the examiner and the board relied on In re Von Bramer, 29 CCPA 1018, 127 F.2d 149, 53 USPQ 345, to support the proposition that the statement in Binder that "100% cis-1,4 * * * cannot be made" precludes issuance of a patent on the appealed claims.

We find persuasive the reasoning set forth in Phillips Petroleum Company v. Ladd, 219 F.Supp. 366, 138 USPQ 421 (D. D.C. 1963), the facts of which are strikingly similar to the present facts relevant to the issue of "anticipation." In that case the claims were drawn to include a rubbery 100% cis-1,4-polybutadiene. The solicitor there, as here, argued that the claims were anticipated by the conclusion in the same Binder article that the rubber could not be made. The court[6] said, 138 USPQ at 423-424:

> "With respect to the so-called disclosure in the Binder patent [sic], the position of counsel for defend-

[6] Jackson, J., retired Associate Judge of the Court of Customs and Patent Appeals, who, incidentally, was the author of the Von Bramer opinion.

ant is that since 100% cis is mentioned, it is such a disclosure as would deny patentability to the claims herein. Based upon the evidence, and a thorough analysis of Binder, it seems clear to the Court that defendant's contention amounts to nothing more than a vague negative hypothesis."

"With respect to products, distinguishing them from mere names, the involved polymers are defined by critical limitations, were not predictable, differed in kind from the prior art products, had not been made, and probably could not have been attained, until the present inventors made their discovery."

"Counsel for the defendant relied principally upon the case of In re Von Bramer, 127 F.2d 149, 29 CCPA 1018, 53 USPQ 345. In the opinion of the Court the Von Bramer case differs in its facts from the instant case. In that case, as maintained by counsel for plaintiff, the prior art disclosure was what is known as the 'Geneva' name of a chemical compound defining molecular structure. The properties claimed in the Von Bramer case differed only in degree from those admittedly disclosed in the prior art. As far as the predictable properties of the Von Bramer case is concerned, they were found in any similar compound, and those compounds were capable of synthesis by recognized classical organic reactions."

"Furthermore, in that case there were statements in a number of prior art references that the compound relied upon as anticipatory had been made and used, and that the five carbon atom alkyl limitation in that case contradicted the statement of the invention in the specification as an arbitrary and meaningless distinction from the prior art."

"* * * Polymers in the instant case differ in kind from the properties of polybutadienes of the prior art, and likewise, have properties which are unpredictable

in light of the prior art. Those polymers had not been made by any method of synthesis by skilled workers in the art, including Dr. Binder who made that admission in the reference, although many highly skilled scientists in the art had been working on these projects."

"Dr. Binder stated that he knew of no way to make 100% cis 1, 4 polybutadiene at any practical temperature, and there is a lack of any prior art statement that any such cis polybutadiene had ever been made, * * *."

Regarding the rejection predicated on full disclosure by Binder and reliance on the Von Bramer decision, we cannot sustain that rejection for the reasons given in the Phillips case with respect to the same prior art disclosure.

Considering the rejection on the ground of "unpatentability over" Binder, appellant points out that the board withdrew a rejection based on a patent to Greene after appellant submitted an affidavit under Rule 131. Appellant argues that the affidavit establishes a date of invention prior to the publication date of the Binder reference, and that this court's decision in In re Palmquist, 51 CCPA 839, 319 F.2d 547, 138 USPQ 234, compels a finding that Binder cannot be considered in establishing obviousness of the claimed invention under 35 U.S.C. 103.[7]

The solicitor points out that the Palmquist decision did not overrule In re Wenzel, 24 CCPA 1050, 88 F.2d 501, 33 USPQ 30, and states that Bros Inc. v. Browning Mfg. Co.,

[7] In view of the fundamental nature and relative simplicity of the invention here in issue, we assume that the Greene patent, which is not in the record before this court, discloses approximately the same information as the Binder article. No issue has been raised as to the showing that the proofs accepted for withdrawal of the Greene patent are sufficient to establish a date of invention prior to the effective date of the Binder reference.

317 F.2d 413, 137 USPQ 624, "appears to be contra to the Palmquist case." The solicitor also argues that the polymers listed on Binder Table V and the claimed polymer "are only so slightly *different* from the latter structure as to be of no legal significance," [emphasis present] and that

> "* * * the slight differences in the amount of cis-1, 4 and 1, 2 structure between the polymer of the claims and that of Binder does not come within the purview of the requirement for unobviousness of Section 103 to justify allowance of a patent. Even under the Palmquist case it is doubted that this difference would be acceptable."

It is assumed by both parties—and it is unquestionably true—that when a reference fully discloses in every detail the subject matter of a claim, the statutory basis of a rejection on that reference is 35 U.S.C. 102(a) if the reference date is before the applicant's *date of invention,* thereby establishing want of novelty, and section 102(b) if the reference date is more than one year prior to the actual United States *filing date,* thereby establishing a so-called "statutory bar," more accurately, a one-year time-bar which results in loss of right to a patent, regardless of when the invention was made. In either of these situations, it is often said that the invention is "anticipated" by the reference and the reference is termed an "anticipation."

Proofs submitted in this case under Patent Office Rule 131 with respect to a reference not before us (because it was overcome thereby) have established that the applicant's invention date was prior to December 26, 1952. The Binder reference is the August 1954 issue of a periodical. It is seen, therefore, that it is subsequent to the date of invention but more than one year prior to the filing date, which was August 21, 1956. This is the same relationship of dates which existed in Palmquist as regards the Van

Boskirk reference. Since the date of invention is earlier than the reference date, section 102(a) is necessarily inapplicable because the printed publication was not "before the invention thereof by the applicant" and there is statutory novelty. This leaves paragraph (b) of section 102 as the only paragraph of that section having possible relevancy.

It is appellant's position, as stated in his Reply Brief, that

> "The *only* issue on this appeal is whether the claims define subject matter which is obvious in view of the reference and hence unpatentable under 35 U.S.C. § 103. * * *"

Deeming that to be the sole issue, appellant further contends that the assumed rejection under section 103 is not before the court because, under Palmquist, the Binder reference has been disposed of by the proof of an invention date prior to the date of Binder and this reference is not before us. Disposing of the sole reference in this manner of course disposes of the "unpatentable over" rejection.

There is a difference in the facts in this case from the facts in Palmquist in that there is only one reference here, there being differences between the claimed subject matter and the reference disclosure which the Patent Office contends would be obvious to one of ordinary skill in the art, whereas in Palmquist the claims were rejected on various combinations of two or three references, each combination involving one reference which had a date subsequent to the date of invention but more than one year prior to applicant's filing date. The Patent Office seeks to distinguish Palmquist on the basis of the differences in the factual situations. As will appear from what follows, we consider this difference to be of no legal significance.

Because of the importance of the question to the law of patents, we have deemed it desirable to reconsider what

is the statutory basis of this "unpatentable over" or obviousness type of rejection, such as we have here and had before us in Palmquist, under the circumstance that *the reference or references have effective dates more than one year prior to the filing date of the applicant.* More specifically, we have reconsidered the result again urged on us here, as allegedly authorized by section 103, that a reference having a date more than a year prior to the filing date may be disposed of by showing an invention date prior to the reference date, contrary to the express provision in Patent Office Rule 131.[8]

Sections 101, 102 and 103, generally speaking, deal with two different matters: (1) the factors to be considered in determining whether a patentable invention has been *made,* i.e., novelty, utility, unobviousness, and the categories of patentable subject matter; and (2) "loss of right to patent" as stated in the heading of section 102, even though an otherwise patentable invention has been made. On the subject of loss of right, appellant's brief contains a helpful

---

[8] *131. Affidavit of prior invention to overcome cited patent or publication.* (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, *unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.* [Emphasis ours.]

The italicized clause at the end of the foregoing paragraph or its equivalent has been present in the rule and its predecessor Rule 75 sinc January 1, 1898, when the rule was amended to include:

> "* * * unless the date of such patent or printed publication is more than two years prior to the date on which application was filed in this country."

review of the development of the statutory law since 1793. It says:

> "In 1897 the patent laws were amended to make the * * * two-year bar period apply to all public uses, publications and patents *regardless of the source* from which they emanated. The change was a consequence, primarily, of greatly improved communications within the country which had rendered inventors easily able to acquire knowledge of the public acts of others within their own fields. It was reasoned that any inventor who *delayed in filing* a patent application for more than two years after a public disclosure of the invention would obtain *an undeserved reward in derogation of the rights of the public* if he were granted a patent."
>
> "In 1939, in recognition of further improvements in communications, Congress reduced the two-year bar period to one year. * * *"
>
> "That 1939 Act was carried over unchanged in the 1952 recodification of the patent laws as 35 U.S.C. § 102(b). * * *"
>
> "Manifestly, Section 102(b) from its earliest beginnings has been and was intended to be directed toward the encouragement of *diligence* in the filing of patent applications and the protection of the public from monopolies on subject matter which had already been fully disclosed to it."

These statements are in accord with our understanding of the history and purposes of section 102(b). It presents a sort of statute of limitations, formerly two years, now one year, within which an inventor, even though he has made a patentable invention, must act on penalty of loss of his right to patent. What starts the period running is clearly the availability of the invention *to the public* through the categories of disclosure enumerated in 102(b), which include "a printed publication" anywhere describing

the invention. There appears to be no dispute about the operation of this statute in "complete anticipation" situations but the *contention seems to be that 102(b) has no applicability where the invention is not completely disclosed in a single patent or publication,* that is to say where the rejection involves the addition to the disclosure of the reference of the ordinary skill of the art or the disclosure of another reference which indicates what those of ordinary skill in the art are presumed to know *and to have known for more than a year before the application was filed.* Upon a complete reexamination of this matter, we are convinced that the contention is contrary to the policy consideration which motivated the enactment by Congress of a statutory bar. On logic and principle we think this contention is unsound, and we also believe it is contrary to the patent law as it has actually existed since at least 1898.

First, as to principle, since the purpose of the statute has always been to require filing of the application within the prescribed period after the time the public came into possession of the invention, we cannot see that it makes any difference *how* it came into such possession, whether by a public use, a sale, a single patent or publication, or by combinations of one or more of the foregoing. In considering this principle *we assume, of course,* that by these means *the invention has become obvious* to that segment or [sic] the "public having ordinary skill in the art." Once this has happened, the purpose of the law is to give the inventor only a year within which to file and this would seem to be liberal treatment. Whenever an applicant undertakes, under Rule 131, to swear back of a reference having an effective date more than a year before his filing date, he is automatically conceding that he made his invention more than a year before he filed. If the reference contains enough disclosure to make his invention obvious, the principle of the statute would seem to require denial of a patent to him. The same is true where a combination of

two publications or patents makes the invention obvious and they both have dates more than a year before the filing date.

As to dealing with the express language of 102(b), for example, "described in a printed publication," technically, we see no reason to so read the words of the statute as to preclude the use of more than one reference; nor do we find in the context anything to show that "a printed publication" cannot include two or more printed publications.[9] We do not have two publications here, but we did in Palmquist, and it is a common situation.

As to what the law has been, more particularly what it was prior to 1953, when the new patent act and its section 103 became effective, there is a paucity of direct precedents on the precise problem.[10] We think there is a reason for this. Under the old law (R. S. 4886, where 102(b) finds its origin) patents were refused or invalidated on references dated more than a year before the filing date because the invention was anticipated or, if they were not then *because there was no "invention,"* the latter rejection being based either on (a) a single nonanticipatory reference plus the skill of the art *or (b) on a plurality of references.* There was no need to seek out the precise statutory basis because it was R.S. 4886 in any event, read in the light of the Supreme Court's interpretation of the law that there must always be "invention." This issue was determined on the disclosures of the references relied on and if they had

---

[9] The construction of section 102(b) is subject to the provision of 1 U.S.C. 1 which provides in pertinent part:

> "In determining the meaning of any Act or resolution of Congress, words, importing the singular number may extend and be applied to several persons or things; * * * unless the context shows that such words were intended to be used in a more limited sense; * * *"

[10] For an attempt to relate prior decisions to the problem, see 32 Geo. Wash. L. Rev. 656.

dates more than one year before the filing date, it was assumed they could be relied on to establish a "statutory bar." There was an express prohibition in Rule 131 and in its predecessor Rule 75 against antedating a reference having a date more than a year prior to the filing date and there was no basis on which to contest it. The accepted state of law is exemplified by the following sentences in McCrady's Patent Office Practice, 4th ed. (1959), Sec. 127, p. 176:

> "Prior art specified by 35 U.S.C. 102, which has an effective date more than one year prior to the effective filing date of an application, constitutes a bar under the language of that statute. Until 1940 the period was two years."
>
> * * *
>
> "Procedurally, the significance of the statutory bar lies in the fact that it cannot be antedated by evidence of applicant's earlier invention, as by affidavits under Rule 131, or by evidence presented in an infringement suit."

Our decision in Palmquist appears to have been the first to hold otherwise.

The various editions of Walker on Patents from an early time have included this statement, quoted from the 2nd Deller Edition § 141 (§ 87 in 1st Dell. ed.):

> "Precise identity between the thing covered by the patent and the thing which the inventor allowed to be in public use or on sale more than the statutory period before he applied for the patent is not necessary to constitute constructive abandonment of the invention covered by the later. It is enough * * * if the advance from one to the other did not amount to invention [Int'l Tooth Crown Co. v. Gaylord, 140 U.S. 55 (1891)]."

Thus the "statutory bar" has not been limited to "complete anticipation" fact situations where the complete disclosure of the invention is to be found in a single reference. At least the skill of the art has been added to the disclosure of the reference or the thing in public use in finding a bar to the grant of a valid patent, utilizing the standard pre-1953 terminology of "no invention."

It would seem that the practical operation of the prior law was that references having effective dates more than a year before applicant's filing date were always considered to be effective as references, regardless of the applicant's date of invention, and that rejections were then predicated thereon for "lack of invention" without making the distinction which we now seem to see as implicit in sections 102 and 103, "anticipation" or no novelty situations under 102 and "obviousness" situations under 103. But on further reflection, we now feel bound to point out that of equal importance is the question of *loss of right* predicated on a one-year *time-bar* which, it seems clear to us, has never been limited to "anticipation" situations, involving only a single reference, but has included as well "no invention" (now "obviousness") situations. It follows that where the time-bar is involved, *the actual date of invention becomes irrelevant* and that it is not in accordance with either the letter or the principle of the law, or its past interpretation over a very long period, to permit an applicant to dispose of a reference having a date more than one year prior to his filing date by proving his actual date of invention.

Such a result was permitted by our decision in Palmquist and to the extent that it permitted a reference, having a publication date more than one year prior to the United States filing date to which the applicant was entitled, to be disposed of by proof of a date of invention earlier than the date of the reference, that decision is hereby overruled.

We wish to make it clear that this ruling is predicated on our construction of section 102(b) and has no effect on the statements in Palmquist respecting the determination of obviousness under section 103 when a statutory time-bar is not involved. The existence of unobviousness under that section, as a necessary prerequisite to patentability, we reiterate, must be determined as of "the time the invention was made" without utilizing after-acquired knowledge.

The determination of unobviousness, however, relates to the determination of whether a patentable invention has been *made*. Whether there has been a *loss of right to a patent* on such invention is a distinct and separate issue, with which section 103 per se has nothing whatever to do. Its legislative history, which is well known and uncomplicated, shows that section 103 had but a single purpose which was to add to the statute a provision to take the place of the judge-made "requirement for invention." In doing that, the history also shows, the words "at the time the invention was made" were included for the sole purpose of precluding the use of hindsight in deciding whether an invention is obvious. We are sure Congress had no intent thereby to modify the law respecting *loss of right* based on the existence of a time-bar. We have therefore concluded that we were wrong in accepting the appellants' contentions in Palmquist that those words enabled Palmquist and Erwin to dispose of a reference relied on to establish a one-year bar by showing a date of invention earlier than the date of the reference. The wrong in such a construction of the statute—beside giving it a meaning that was never intended—is that it permits an inventor to sleep on his rights more than a year after the invention has become entirely obvious to the public, whereby the public has potential possession of it, and still obtain a patent which will take the invention from the public, a result Congress could not possibly have intended in view of its express indication that section 102(b) is merely a continuation of the prior law.

Since we must reject Foster's contention that he can dispose entirely of Binder by showing an earlier invention date, it becomes necessary for us to consider whether there was a loss of right to a patent, i.e., whether the invention became obvious to the public at the time of the Binder publication. Appellant has fully argued this issue in his briefs.

The solicitor contends that all claims were rejected over the Binder disclosure of polymer "39-1" which contains 22.7% cis-1,4 and 60.0% trans-1,4 structures. We cannot agree. Our analysis of the record indicates that polymer "39-1" was never employed in the rejection of claims 22, 23, 25, 26 and 28. Those claims specify a minimum 1, 4 content and were rejected only as being anticipated by the 100% cis-1,4-disclosure of Binder. Although the solicitor argues that claims such as 25 which calls for a polymer having 85% head-to-tail structure are obvious in view of the "39-1" polymer which has 82.7% 1, 4-structure, we do not feel that we can properly consider that argument since appellant was not afforded a proper opportunity to meet these arguments which were made neither by the examiner nor by the board.

The "39-1" polymer, as well as others from Table V of Binder, did clearly form the basis of rejecting the remaining claims. Since the cis-1, 4 content formed the basis of the examiner's comparison of the appellant's polymers with those of Binder, we shall group the claims for discussion on the basis of the cis-1, 4 content specified. Claim 34 calls for "at least about twenty-nine per cent of said monomer units being present in cis-1, 4 structure." Claim 35 calls for "from about thirty to about fifty-seven per cent of said butadiene monomer units being present in cis-1, 4 structure."

After a rejection based upon the "39-1" polymer and a polymer containing 22.4% cis-1,4, 60.5% trans-1,4 and 17.1% 1, 2 which was designated by Binder as polymer

"1140," appellant submitted an affidavit comparing his "Diene rubber," a polybutadiene containing 29.1% cis-1,4; 61.3% trans-1,4; and 9.6% 1,2 with ten polymers disclosed by Binder. This affidavit by Dr. Bernard L. Johnson, an employee of Firestone, indicated that precise duplication of the Binder polymerization methods was possible because all of the Binder work had been done at Firestone and Binder's original data was still available. Furthermore, Binder determined the miscrostructures and properties of the reproduced polymers. Despite this assistance, however, Johnson was unable to reproduce several polymers including the "1140" polymer. Instead, he obtained a fluid containing 19.2% cis-1,4; 61.1% trans-1,4 and 19.1% 1, 2-structures. All of the other reproduced polymers were rubbery solids. The board stated that the "1140" polymer was the closest prior art and thus could not accept appellant's showing as being a comparison with the closest Binder polymer.

The solicitor has pointed out what he considers to be another defect in the affidavit. The "Diene rubber," a butadiene homopolymer, was compared with various butadiene homopolymers and butadiene-styrene copolymers, but was not compared with "FR 89-2," the closest butadiene homopolymer disclosed by Binder. We note that although "Diene rubber" was not compared with "FR 89-2" which contained 21.9% cis-1,4, it was compared with "FR 89-1" which contained 20.5% cis-1,4. The criticisms raised by the board and the solicitor may bear on the weight to be given the affidavit, but they do not preclude our consideration of the affidavit.

Several of the Binder polymers are as good as or better than "Diene rubber" with regard to strength as measured by dynamic modulus and static modulus. However, the "Diene rubber" is clearly superior with regard to several other properties. Heat build up, as evidenced by relative energy absorption at constant force, is from about 53% to over 540% higher in the Binder polymers. The rebound

value of the "Diene rubber" is from 40% to over 100% greater at room temperature and when cured in a tread stock from about 40% to 170% greater at room temperature and from 18% to about 200% greater at 212° F. than the rebound values of the Binder polymers. The "Diene rubber" resistance to low temperatures, as evidenced by Young's Bending Modulus, is from 20% to 170% greater than that of the Binder polymers. It should be noted that in all of these tests the Binder "FR 89-1" butadiene homopolymer containing 20.5% cis-1,4 performed the best or close to the best of all of the Binder polymers tested. We are convinced, however, that appellant's "Diene rubber" containing 29.1% cis-1,4-polybutadiene has properties superior to and is patentable over the Binder polymers, all of which contain less than 23% cis-1,4-structure.

We have considered the solicitor's argument that because natural rubber contains 97.8% cis-1,4-structure, it would be obvious to increase the cis-1, 4 content of the Binder polymers to obtain the properties achieved by appellant in his "Diene rubber." We cannot agree with this position. Natural rubber contains isoprene units, not butadiene units. Thus, appellant has discovered that his "Diene rubber" (polybutadiene) has properties similar to or better than natural rubber (polyisoprene). We, accordingly, *reverse* the rejection of claims 34 and 35.

Another group of claims, 12, 13, 29 and 39, specifies a cis-1, 4 content of as low as 23%, only a fraction of a per cent more than the Binder polymers have. The board held that the affidavit failed to show a difference between the Binder polymers and the claimed 23% cis-1, 4 polymers. Appellant has not introduced evidence to show that the 23% cis-1,4 containing polymer has properties differing in any way from the Binder polymers. Neither has he shown that the 23% cis-1,4 containing polymers are more closely related to his 29.1% cis-1,4 containing "Diene rubber" than to the Binder polymers. He also failed to present arguments that the small percentage differences in the total 1,4

content are significant. Thus, we agree with the board that the mere difference of a fraction of a percent does not render the claims unobvious in view of Binder.

Claims 17 and 18 are drawn to sulfur-cured vulcanizates of the 23% cis-1,4 containing polymers. Appellant has not argued that sulfur curing would be an unobvious treatment of the products. We thus agree with the solicitor that these claims must fall with the polymer claims.

Product claims 30, 32, 33, 36 and 40 contain limitations specifying the method of forming the 23% cis-1,4 containing polymer, e.g., "said synthetic polymer being formed in the presence of an ionic catalyst in a substantially nonaqueous system * * *." While it is appellant's position that high cis-1, 4 contents cannot be achieved by Binder's polymerization process, he has not argued in his brief that there is an unobvious difference between the claims based upon the method limitation. Because appellant has not shown that polymers containing 23% cis-1, 4-structure produced according to his claims must differ significantly from the Binder polymers, we agree with the board.

We, accordingly, *reverse* the decision of the Board of Appeals with regard to claims 22, 23, 25, 26, 28, 34 and 35. The rejection of claims 12, 13, 17, 18, 29, 30, 33, 36, 39 and 40 having been *affirmed* because the appellant has lost his right to these claims, the decision is *modified.*

WORLEY, Chief Judge, concurring.

Had not circumstances prevented my participation in Palmquist, I doubtless would have joined my colleagues in adopting appellants' then plausible interpretation of Section 103. There can be no doubt that the language therein, when interpreted *literally* and standing *alone,* supports Palmquist. But, as the majority makes so clear here, we misinterpreted Congressional intent there. No court is infallible, and the margin for error becomes greater in the complexities of patent law, increasing with the heavy case

load[1] the court is attempting to carry. It is comforting to note that on those happily rare occasions when mistakes are made the court has not hesitated to set the record straight and prevent bad law from becoming precedent for more bad law.

That Palmquist was new law[2] is evident from In re Wenzel, 24 CCPA 1050, 88 F.2d 501, 33 USPQ 30; In re Ruscetta, 45 CCPA 968, 255 F.2d 687, 118 USPQ 101; Ex parte Austin, 72 USPQ 384. That the result there was also foreign to Congressional intent and policy is equally clear. For example, the statute is designed to *encourage* early filings so the public may the sooner benefit, yet Palmquist discouraged that goal. Indeed, it placed a premium on late filing, and created a virtual open season on the public by permitting "obvious" subject matter already in the public domain for more than one year to be patented.[3] I am confi-

---

[1] In 1958 patent appeals to this court totaled 83; six years later the number had reached 245, a 200% increase.

[2] In this connection, it is not without interest to note that Foster did not argue at any time before the board that his Rule 131 affidavit removed the Binder publication as a reference. The board's decision on reconsideration is dated Sept. 17, 1962. This court rendered its decision in Palmquist on June 28, 1963.

[3] In further consideration of the record before us here, it seems to me that the subject matter of claims 25, 26 and 28, as broadly stated, is unpatentable under 35 U.S.C. 102(b) alone, because the subject matter was described in toto in the Binder printed publication more than one year prior to appellant's filing date. In concentrating upon the rejection of those claims over the "conclusion" portion of Binder, the Patent Office appears to have overlooked several polymers of butadiene and copolymers of butadiene-styrene disclosed by Binder which have "at least 85%" of the butadiene units joined in head-to-tail or 1, 4 addition polymer structure as called for in the claims. Those polymers, appearing in Tables 1 and 2 of Binder, are identified, for example as Polymer Nos. 995, 1075, 1060 and 1113. However, the jurisdiction of this court being limited under 35 U.S.C. 141-144, we cannot enter a new ground of rejection. In re Thompson, 52 CCPA 770, 336 F.2d 604, 143 USPQ 21. I comment no further on the patentability of those claims without the benefit of the views of the Patent Office and appellant.

dent neither the court nor Congress intended such a result. Nor could either have intended to shroud the validity of issued patents in perennial doubt, or encourage the danger of legal harassment for which Palmquist might well have become a potent source. It is well that we close the door here on those possibilities.

RICH, Judge, concurring.

In view of the opening remarks of Judge Smith's dissent and because of the unusually long time the decision in this case has been gestating, I merely wish to record the fact that last August I first developed the tentative view that we committed an error of law in Palmquist and became firmly convinced of it and of its exact nature in early October after reviewing the Palmquist record. I regret that until then I had not fully appreciated the explicit and detailed reliance by the examiner in that case on the existence of a one-year bar and on 35 U.S.C. 102(b) as the basis of his rejection.

SMITH, Judge, dissenting.

Less than two years ago I spoke for a unanimous court in the Palmquist case. Today I find myself the lone dissenter from a decision which overrules it. What has happened in the interim to convince three of the original participants in that short-lived decision that it should be overruled?

The answer emerges from the opinions of the majority and from various commentaries on the Palmquist case.[1] Very simply this answer is that neither sections 102 and 103 of the Patent Act of 1952 cover the situation presented here or in Palmquist. To plug the "hole" which has been shown to exist in the Patent Act of 1952, the majority rests

---

[1] See Sobel, Prior Art and Obviousness, 47 J. Pat. Off. Soc'y 79 (1965), a substantial portion of which is given over to a discussion of Palmquist and related cases. Palmquist is noted in 13 Am. U.L. Rev. 211 (1964) and 32 Geo. Wash. L. Rev. 656 (1964).

its opinion upon the unsupportable premise that sound patent policy dictates that an inventor shall lose his right to a patent in every case in which his invention becomes obvious at any time prior to one year before he files his patent application.

I am convinced and shall point out in this opinion: 1) that no such broad patent policy exists and 2) even if it did, that this court is not justified in reaching so far to correct a legislative oversight. I shall also point out some of the very undesirable consequences I see flowing from today's decision.

I. *Is there a pervasive patent policy which dictates today's decision?* The answer, of course, is no. There are at least two, and perhaps more situations wherein an invention, unobvious when made, later becomes obvious sometime prior to one year before the application is filed and yet the applicant does *not* lose his right to patent. The following examples will make this clear.

First: At page 171 of the instant majority opinion we find the statement: "Proofs submitted in this case under Patent Office Rule 131 with respect to a reference not before us (because it was overcome thereby) have established that the applicant's invention date was prior to December 26, 1952." What the majority opinion does *not* state is that December 26, 1952 is the *filing* date of this "reference not before us," which is the Greene U.S. Patent 2,762,790 issued a few weeks subsequent to the date on which appellant filed his application. Thus, Greene's application was co-pending with appellant's, and Greene's filing date was something over *three* years prior to appellant's.[2]

[2] The underlying condition specified in rule 131(a) is that the invention be substantially shown or described, but not claimed, in the domestic patent used as the reference. In accepting the affidavits under this rule and removing the Greene patent as a reference, we must assume that the Patent Office considered that this underlying condition of rule 131 had been met and that Greene did describe Foster's invention.

In In re Harry, 51 CCPA 1541, 333 F.2d 920, 142 USPQ 164, we held that 35 U.S.C. 102(e) operates not only in situations where the invention is described in a single patent, but also in situations where the invention is obvious in view of a combination of patent [sic]. Thus in considering the Greene patent as a reference, appellant's invention would, under the Harry case, have become obvious as of the filing date of the Greene application. Since that date is considerably more than one year prior to appellant's filing date, it follows logically from the majority view here that appellant should have been denied his patent because as a matter of law Greene made the invention obvious more than one year prior to the filing date of the Foster application. This is the necessary result it seems to me of the rationale of the majority that an applicant loses his right to a patent under section 102(b) if he fails to file his application for patent within a year after the invention became obvious.

What the Patent Office did here as to the Greene reference is consistent with its past position that the right to patent has not been lost in such situations. The Patent Office applies the reasoning of the majority *only* where the *issue* date of the patent is more than one year prior to the applicant's filing date. I am frankly unable to reconcile this anomaly (an example of which occurred in the Palmquist case as well) with the majority's fundamental proposition that there is an established policy of refusing patents for inventions which have become obvious more than a year prior to filing the application therefor. No such policy is expressed either in section 102(b) or section 103. On the contrary, what the courts and Congress have said is that, if and when under *certain express conditions* the invention becomes vested in the public more than one year prior to filing the application, then and *only* then is there a loss of right to patent. These conditions are stated in section 102 (b) and clearly require that *the invention* be *patented,* or

described in a printed publication or that it be *in public use* or *on sale.*[3]

---

[3] I have found no case law which sanctions the forfeiture of the right to a patent except in those situations where the invention is "described" in a prior patent or printed publication or has gone into public use or on sale. This exception is explicitly stated in 35 U.S.C. 102(b) and is supported by such landmark cases as Bates v. Coe, 98 U.S. 31 (1878), and Parks v. Booth, 102 U.S. 96 (1880). In Bates v. Coe, the patent in suit related to a hand drill and screw cutter consisting of five elementary parts. The defense pleaded that the invention was old and the proofs consisted of several prior patents, each of which disclosed certain of the elementary parts of the patented combination. In rejecting this defense, the Court stated:

> "Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented combination." [98 U.S. at 48.]

While the primary issue in Bates v. Coe was whether the patentee was the first inventor, it is clear that the Court intended the stated principle to apply to the other statutory defenses as well.

In Parks v. Booth, the defendant offered proofs that the patentee was not the original and first inventor of the improvement patented, which proof consisted of twelve patents or specifications. The Court, in denying this defense, stated:

> "* * * Suffice it to say in that regard that all of them have been carefully examined to the extent of the means furnished by the transcript, and the court is of the opinion that no one of the documents is of a character to sustain the issue that the complainant is not the original and first inventor of the improvement."
>
> "Most or all of the inventions described in those publications bear more or less resemblance to that claimed by the complainant, and it may be that if it were allowable to test the

Second: Another example from which it can be seen that there is no such broad policy as stated by the majority, arises from a consideration of section 102(a) and what is

---

validity of the invention in question by comparing the same with the whole as if embodied in a single exhibit, the evidence might be sufficient to support the views of the respondents in respect to the defence under consideration. Were that allowable it might well be suggested that the screen is found in one, the box in another, and the means to produce the lateral shake in a third, and so on to the end; but it would still be true that neither the same combination in its entirety nor the same mode of operation is described in any one of the patents or printed publications given in evidence."

"Attempt is scarcely made in argument to show that any one of these exhibits embodies the entire invention of the complainant, but it is insisted that every feature of the patented improvement is found in some one or more of those publications. Suppose that is so, still it is clear that such a concession, if made, could not benefit the respondents, unless they can be allowed to extend the same comparison to two or more exhibits, as they do not contend that the entire invention is superseded by any one of their exhibits."

"Where the thing patented is an entirety, consisting of a separate device or a single combination of old elements incapable of division or separate use, the respondent cannot make good the defence in question by proving that a part of the entire invention is found in one prior patent, printed publication, or machine, and another part in another, and so on indefinitely, and from the whole or any given number expect the court to determine the issue of novelty adversely to the complainant. Bates v. Coe, 98 U.S. 31."

"Common justice forbids such a defence, as it would work a virtual repeal of so much of the Patent Act as gives to inventors the right to a patent consisting of old elements, where the combination itself is new and produces a new and useful result. New elements in such a patent are not required, and if such a defence were allowed, not one patent of the kind in a thousand of modern date could be held valid. Nor is such a defence consistent with the regulations enacted by Congress in respect to the procedure in litigations in respect to patent-rights." [102 U.S. at 103-04.]

meant by the term "known" as used therein. The case law indicates that for an invention to be "known," the "knowledge" of it must be of a very special kind and quality in order to be effective as an anticipation. This court held, in In re Schlittler, 43 CCPA 986, 234 F.2d 882, 110 USPQ 304, that such knowledge must be *available to the public and,* moreover that it must be knowledge of a *reduction to practice* of the invention against which it is cited.

It seems clear that this kind of knowledge—the kind required for anticipation under section 102(a)—certainly puts the invention in the possession of the public. And yet, section 102(b) does not base a *loss of right to patent* on such knowledge unless it has been "packaged," as it were, in a patent or a publication or in something which has gone into public use or on sale, prior to one year before the filing date of the application.

These examples seem to me to show the incorrectness of the majority position that there is a broad policy which demands a forfeiture of the right to patent in every case in which the public has possession of the invention for more than a year prior to filing of the application.

II. *Even if there were such a pervasive policy, it is an usurpation of the legislative function for this court to rewrite the statute.* In Sturges v. Crowninshield, 4 Wheat. (17 U.S.) 122 (1819), Chief Justice Marshall was moved to comment upon the need for a zealous judiciary to exercise restraint concerning inadequate legislative enactments. His eloquent words, written nearly a century and a half ago, are a remarkably current and valid summary of my views regarding the instant case; thus:

> "* * * although the spirit of an instrument, especially of a constitution, is to be respected not less than its letter, yet the spirit is to be collected chiefly from its words. It would be dangerous in the extreme, to infer from extrinsic circumstances, that a case for which the

words of an instrument expressly provide, shall be exempted from its operation. Where words conflict with each other, where the different clauses of an instrument bear upon each other, and would be inconsistent, unless the natural and common import of the words be varied, construction becomes necessary, and a departure from the obvious meaning of words, is justifiable. But if, in any case, the plain meaning of a provision, not contradicted by any other provision in the same instrument, is to be disregarded, *because we believe the framers of the instrument could not intend what they say,* it must be one in which the absurdity and injustice of applying the provision to the case, would be so monstrous, that all mankind would, without hesitation, unite in rejecting the application. This is certainly not such a case. * * *" [Emphasis added.]

Current validation of this point of view is supplied by Crawford's The Construction of Statutes at p. 249 which states:

"* * * if the language is unambiguous and the statute's meaning is clear the statute must be accorded the expressed meaning without deviation, since any departure would constitute an invasion of the province of the legislature by the judiciary."

The language of sections 102(b) and 103 is unambiguous, its meaning is clear, and I see no valid basis for deviation from it in deciding the present case.[4]

---

[4] Webster's New International Dictionary (2d ed. 1954) defines "describe" in pertinent part as "2. To represent by words written or spoken * * * to state in detail the particulars of; * * * now esp., to give a mental image of; to depict verbally; as to *describe* a view, a person." The same source defines "obvious" as "2. Easily discovered, seen, or understood; plain; evident * * *."

Thus it would appear that the choice of language in section 102 (b) requiring, as it does, that *the invention* be *described,* has carried

Yet, the majority decision amounts to an interpretation of section 102(b) as though it contained the following underscored words:

> "A person shall be entitled to a patent unless—
>
> * * * (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country *or unless the invention became obvious* more than one year prior to the date of the application for patent in the United States * * *."

Thus, within the rationale of the majority opinion and its construction of section 102, it is no longer necessary for a patent or a publication to "describe" the invention to lay the basis for the loss of right to a patent under section 102(b). It is sufficient that a patent or a publication be found, or that some combination of the same can be put together after the applicant's date of invention and with the accuracy characteristic of perfect hindsight which make

---

in to the statute the legal concepts expressed in Bates v. Coe and Parks v. Booth, supra note 3, i.e. that "anticipation" within the purview of section 102 requires that a description of the entire invention, not just some part of it, must be found in the patent or printed publication relied upon. This view is supported also by the express language of section 103, which is to apply when "the invention is not *identically disclosed or described* as set forth in section 102 * * *." (Emphasis added.) Under section 103 it is sufficient if the invention be "obvious" from the prior art. The section also includes the safeguard that this determination must be made "at the time the invention was made" and thus negates the "hindsight" and "piecemeal" reconstruction of the prior art which the Supreme Court recognized as a danger in Parks v. Booth. Quaere: If an invention is "obvious" under section 103 (although not "at the time the invention was made"), and the majority equates it with a "described" invention under section 102, do "obvious" and "described" now mean the same thing in the field of patent law?

the invention "obvious" more than one year prior to the date of filing the patent application. Thus, in addition to changing the wording of section 102(b) as above suggested, the majority must also intend to rewrite section 103 so that the phrase "at the time the invention was made" now is to be limited by a proviso which reduces this time to a period of one year prior to the filing of the application.

Thus it becomes pertinent to inquire whether such was the intent of the drafters of the Patent Act of 1952 or of the Congress in enacting it. While I think it was not, I speak here simply as a minority of one in expressing this point of view, however, I think these considerations support my position that such effects should be accomplished *only* by legislation, and not by a judicially imposed statutory construction.

A patent statute, like a patent claim, should be more than a mere "nose of wax which may be turned and twisted in any direction." Cf. White v. Dunbar, 119 U.S. 47, 51 (1886). Often a particularly loosely worded statutory provision can come very near to being all things to all people. But all statutes have an elastic limit, and stretching them beyond that point results in a flaccid collection of words, vulnerable and open to attack from all sides and a far cry from the legislative instrument that was intended. I am not persuaded by the majority opinion that this court should undertake by "interpretation" to rewrite key provisions of sections 102(b) and 103 according to judicial fiat. I think it is the Congress and not this court which should correct the oversight, if any, which may be present in the statute.

In the previous discussion, I have indicated something of the complexities of the problems here involved. Such problems lie peculiarly within the province of the Congress, where the instruments of investigation, public hearings and exhaustive debate can measure and determine the public

interest and state the proper public policy far more accurately than it can be done in this court.[5]

III. *Some logical problems and the undesirable consequences of the majority viewpoint.* In concluding, I shall comment on some of the undesirable consequences of today's decision. Others will undoubtedly perceive different problems, and the passage of time will surely create even more but in the following paragraphs I shall outline some of the matters that have been and are troubling me.

Consider what the majority has done in its opinion. One would have supposed, in view of the fact that the issue appears to be "loss of right to patent" under section 102 (b), that the majority would have decided this issue. Thus, one would have supposed the majority would first determine whether there was a right to a patent. I think the record is clear that Foster met every statutory standard to establish patentability of his invention on its merits. Clearly, the invention is new and unobvious under sections 102(a) and 103, respectively, since neither the Binder nor the Greene references were *in existence* at the time the invention was made. On the present record Foster *had* a right to

---

[5] For a further exposition of these considerations, see the dissenting opinions of Justices Frankfurter and Harlan in Baker v. Carr, 369 U.S. 186, 266, 330 (1962).

With respect to the instant majority's characterization of section 102(b) as presenting "a sort of statute of limitations," see Eclipse Lumber Co. v. Iowa Loan & Trust Co., 38 F.2d 608, 610 (8th Cir. 1930):

> "While the general rule is that statutes of limitation are to be given a liberal construction as statutes of repose * * * [citing cases], they are not to be extended to cases not within their provisions. * * * " [Citing cases.]
>
> "A statute limiting the time to bring an action to enforce a mechanic's lien cannot be extended, by construction, to include within its terms the equitable action, authorized by section 3103, given to persons who can have no mechanic's liens. Where the language of a statute is plain, there is no room for construction. * * *" [Citing cases.]

a patent. Thus the only remaining question is whether he *lost* that right, under the provisions of section 102(b). And the majority's answer to this is (after overruling Palmquist): Yes, he lost his right to patent, since the Binder reference made the invention obvious more than a year before Foster filed his application.

Contrary to this simple approach and what might be supposed from these considerations, the majority opinion does not decide this issue. In overruling Palmquist, the majority gives lip service to the truism that "section 103 has nothing whatever to do" with the issue of loss of right to patent, but then proceeds to decide the case as one of obviousness using Binder as *prior art* under section 103, which it most emphatically is not, since it *did not exist* "at the time the invention was made."[6]

If the four members of the majority of this court cannot make clear which section of the statute or which underlying rationale they are applying, I hesitate to guess what an applicant in the future will face in the way of indefinite and evasive rejections from the Patent Office. Today's decision destroys any meaningful differences that may have existed in the past between sections 102(a) and (b) and section 103. This is evident from the way in which the majority opinion vacillates between sections 102 and 103 to support its affirmance of a rejection of the claims as "unpatentable over" the Binder reference.

Despite my past hopes that the Patent Office would adopt a policy of articulation regarding the statutory ground of rejection, it now seems clear that the majority is satisfied with a simple "unpatentable over" rejection. And since such a rejection can be for the reason that the claimed invention is old, or obvious, or for the reason that the right

[6] "The language of section 103 seems to leave no doubt that the date an applicant made an invention is the point of reference regardless of the existence of the statutory one-year bars. Such bars must be considered alone and not as part of the general knowledge to be imputed to the 'person having ordinary skill,' if later than said date of invention." Woodcock, "What is Prior Art?" in Dynamics of the Patent System 309 (1960).

to patent has been lost, the applicant is put in the position of guessing as to which ground is intended and arguing against each of these reasons, without knowing which one the Office really means or which one will be relied upon in the event of appeal.

The many powerful implications in the term "due process" apply to the patent law as well as they do to other fields. I am frankly unable to reconcile the procedural due process requirements of 35 U.S.C. 132 with the failure of the Patent Office here to comply with the notice requirements of this section.[7] Certainly one need look no further

---

[7] A rejection so vaguely stated may well amount to a denial of the procedural safeguards provided in 35 U.S.C. 132. The affirmed rejection of claims as "unpatentable over" Binder may be a rejection for the reason that Foster's invention was "described" by Binder within the meaning of section 102; or that the statutory bar of section 102(b) has resulted in a loss of right to patent; or that the Foster invention was obvious in view of Binder under the conditions specified in section 103. A rejection so vaguely stated does not discharge the statutory duty imposed on the Commissioner of Patents by section 132. Certainly, it does not provide "such information [to the applicant] * * * as may be useful in judging of the propriety of continuing the prosecution of his application." It furnishes, instead, a constantly shifting ground so that the statutory basis for the rejection by the examiner may well differ from that of the Board of Appeals, even as it affirms the examiner's rejection. Under such circumstances what issue may then be assigned as error for appeal to this court under 35 U.S.C. 142 and be relied on by us for decision under 35 U.S.C. 144? The burden on an applicant is quite different in meeting rejections made under sections 102 and 103. A rejection under section 102 involves a comparison between the subject matter disclosed by the reference and that claimed by the applicant, in order to determine whether the claimed invention is "described" in the reference. See e.g., In re Sheppard, 52 CCPA 859, 339 F.2d 238, 144 USPQ 42. Section 103, on the other hand, requires consideration of the differences between the claimed invention and the prior art, for the purpose of determining whether the claimed subject matter as a whole would have been "obvious" to one of ordinary skill in the art. Thus, the issues arising under the two sections are vastly different and call for the production and introduction of quite different types of evidence.

than the majority opinion to see that the words "unpatentable over" do not impart such information as to enable an applicant to "judge of the propriety of continuing the prosecution of his application" as contemplated by section 132.[8]

Most disturbing of all is the fact that from this day forward obviousness under section 103 will be tested, *not as of the time the invention was made, but as of one year prior to the filing date of the application.*

Prior to the enactment of section 103, the determination of "invention" and the evaluation of the prior art relevant thereto always was made as of the time the invention was made. To now change the meaning of section 103 so that obviousness is tested as of one year prior to the filing date of the application, as it seems to me is required by the rationale of the majority, I think we should have some definite indication that such a change was within the contemplation of Congress in enacting section 103. Certainly, such a change should require more than an inaccurately stated principle of an alleged public policy to engraft the forfeiture provisions of section 102(b) onto section 103.

The majority in its construction of section 103 clearly embraces the historically rejected "hindsight" reconstruction of the prior art for all times except one year before the filing date of the application, a result I feel certain Congress intended to preclude by the very precise wording of section 103.

---

[8] Another aspect of procedural due process which continues to concern me in the present case arises where the rejection appears now to be predicated upon section 103. The Commissioner of Patents has failed to provide a procedure by which an applicant can establish his date of invention as contemplated by section 103. Unless the date of invention be within one year from the filing date of the application, there is no remedy. If the date be within one year from the filing date there is a partial remedy under rule 131. By its context, however, rule 131 precludes an applicant from using it to establish a date of invention more than one year prior to his filing date.

A recent writer in observing that "hindsight" is one of our best-developed faculties"[9] has given current expression to the ancient observation recorded in Ecclesiastes 1:9, 10.[10] I had supposed, very naively as it now appears, that section 103 was bottomed on an awareness of the most human of all failings and that Congress had for this reason required that the determination of obviousness was to be made "at the time the invention was made." Instead, I now learn from the majority opinion that the clear language of this section does not mean what it says. Make no mistake about it, hindsight now is an accepted technique for rejection of an application under section 103 unless the effective date of the reference or combination of references is less than one year prior to the filing date of the application.

---

[9] Eugene S. Ferguson, "The Origins of the Steam Engine," Scientific American, Vol. 210, pp. 98, 107 (January 1964).

[10] "9. The thing that hath been, it is that which shall be; and that which is done is that which shall be done: and there is no new thing under the sun.

"10. Is there anything whereof it may be said See, this is new? It hath been already of old time, which was before us."

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
WASHINGTON

July 1, 1965

Mr. Edward S. Irons
Irons, Birch, Swindler & McKie
1000 Conn. Ave.
D. C.

Re: Ex parte Foster
P. A. No. 7106

Dear Sir:

This is to advise you that the court today denied appellant's petition for rehearing in the above appeal.

The motion by appellant for stay of enforcement of decree of April 15, 1965, is granted and the certificate of the proceedings and decision of this Court and return of jurisdiction to the United States Patent Office of the application to which this appeal is directed is hereby withheld until fifteen days from the termination in the Supreme Court of the United States of any proceedings which may result from the filing of a petition for writ of certiorari in that court.

Very truly yours,

GEORGE E. HUTCHINSON
Clerk

a

CC: Mr. Clarence W. Moore

In the Matter of the Application of Folkers

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

No. 7393

Decided May 13, 1965

Appeal from the United States Patent Office

MARTIN, Judge.

The appealed claims of Karl Folkers' application[1] are directed to N-pantothenyl derivatives of two naturally-occurring amino acids, phenylalanine and histidine, and a method of preparing those derivatives by reacting the corresponding β-alanyl-amino acid with pantoyl lactone. While Folkers' disclosure shows, and he originally claimed, naturally-occurring amino acids in general, only the following four claims remain:

> "12. The process of preparing N-pantothenyl-dl-phenylalanine which comprises reacting N-(β-alanyl)-dl-phenylalanine with pantoyl lactone.
>
> 13. The process of preparing N-pantothenyl-histidine which comprises reacting N-(β-alanyl)-histidine with pantoyl lactone.
>
> 15. N-pantothenyl-dl-phenylalanine.
>
> 16. N-pantothenyl-histidine."

During prosecution, appellant removed a Brown et al. publication by a Rule 131 affidavit which was accepted by the Patent Office as showing a date of completion of the invention in the United States prior to April 1955, the publication date. A subsequently filed affidavit under Rule 132, apparently based on the identical factual showing as that given in the Rule 131 affidavit, carries appellant's date of

---

[1] Application serial No. 862,031, titled "N-Pantothenyl Amino Acids and Processes for Preparing Them," filed December 28, 1959, which is a continuation of application serial No. 558,615, filed January 12, 1956.

completion of the invention back prior to April 1954, the date of the following sole reference relied on:

Baddiley et al. J. Chem. Soc. (London) 1954, pp. 2803-2812.

It is not controverted that Baddiley disclose a process of reacting pantolactone (pantoyl lactone) with β-alanyl amino acids. While Baddiley does not show the β-alanyl histidine or β-alanyl phenylalanine of the claims, other known naturally-occurring amino acids are shown.

The issue presented by the above facts is similar to that in In re Palmquist, 51 CCPA 839, 319 F.2d 552, 138 USPQ 234, the principal difference being that here the rejection involves only one reference. While appellant, in urging that Baddiley has been overcome as a reference, relies on Palmquist, and the solicitor seeks to distinguish that case on its facts, relying on In re Wenzel, 24 CCPA 1050, 88 F.2d 501, 33 USPQ 30, our decision here is governed by In re Foster, 52 CCPA ——, —— F.2d ——, 145 USPQ 166, in which we overruled Palmquist.

Whatever right to a patent appellant may have had at the time the invention was made, it has been lost within the meaning of section 102(b) *if,* indeed, the claimed invention *became* obvious to one of ordinary skill in this art through the publication of the reference more than one year before appellant filed his application.

It was the examiner's view that to be entitled to a patent, appellant must show that the substitution of other naturally-occurring amino acids for those listed in Baddiley would not be obvious. As the board noted, appellant has not controverted the examiner's statement that the claimed invention would be obvious to one of ordinary skill in this art upon viewing Baddiley. Rather, appellant filed an affidavit under Rule 132 in an attempt to remove Baddiley, thus precipitating the issue of whether Baddiley gave rise to a statutory bar. The board held that appellant

could not remove a publication whose date was more than a year prior to his effective U. S. filing date even though the disclosure therein did not identically disclose the claimed invention. The board also agreed with the examiner that the disclosure of the reference was sufficient to show that the claimed invention had been obvious to one of ordinary skill in the art for more than a year. Appellant's brief argues the issue of a statutory bar under section 102(b), which in the exact words of the statute is "loss of right to patent."

The respective dates of the Baddiley publication and of the filing of the parent application being more than a year apart, the time factor of the bar under section 102(b) is satisfied. Of course, if the publication did not describe the claimed invention or make the claimed invention obvious, then appellant could not have lost his right to a patent. However, we think that Baddiley, in showing processes and products which differ from those claimed only in the use of other known naturally-occurring amino acids, rendered the invention obvious at the time of its publication. That publication, although subsequent to the time appellant made the invention, brought the invention within the range of obviousness for more than a year prior to his filing date, and appellant, by virtue of section 102(b), has lost whatever right to patent he once may have had. The decision of the board is therefore *affirmed.*

WORLEY, Chief Judge, did not sit or participate in this decision.

SMITH, Judge, dissenting.

I cannot agree with the result reached in this case, for the reasons set forth in my dissenting opinion in In. re Foster, 51 CCPA ——, —— F.2d ——, 145 USPQ 166, 177-82.

Moreover, just as I cautioned in Foster, we are here confronted with a prime example of denial of procedural

due process to an applicant. The majority opinion fails to inform as to the precise ground of rejection in the present case, but proceeds as though the rejection were grounded on section 102(b). My study of the record has convinced me that no such rejection was ever made.

The examiner's answer states that all the claims were rejected "as being unpatentable over the Baddiley et al reference." This typically amorphous "unpatentable over" rejection tells us nothing, of course, with regard to any statutory reason for rejecting the claims. However, later in his answer the examiner says, "The applicant urges that a rejection under 35 U.S.C. 103 is not valid since he alleges that the subject matter of the claims was not obvious *at the time the invention was made* * * *." This statement makes it clear to me, as I am certain it did to the applicant, that the examiner was thinking in terms of section 103.

In sustaining the examiner's rejection, the Board of Appeals stated:

> "* * * Since the rejection over the Baddiley et al. article is based on 35 U.S.C. 103, appellant reasons that 35 U.S.C. 102(b) is not applicable. * * *"
>
> * * *
>
> "* * * Appellant has improperly interpretated [sic] 35 U.S.C. 103, however, since this section is based upon the prior art specified in Section 102. Thus, even if an invitation is not identically disclosed by a reference available under Section 102(b), a patent may still be refused over the same reference, under Section 103. * * *"

As can be seen from the above statements, the actual rejection made by the examiner and affirmed by the board was based upon section 103.

But instead of deciding the issue of "obviousness" at the time the invention was made, under section 103, the instant majority manufactures and decides an issue of *loss of right to patent under section 102(b).* How this can be done is an extremely puzzling question to contemplate, particularly in view of the statement in the Foster majority opinion that "Whether there has been a *loss of right to a patent* * * * is a distinct and separate issue, with which section 103 per se *has nothing whatever to do.*" (Latter emphasis added.)

Small wonder then that, as the majority opinion so candidly puts it "appellant has not controverted the examiner's statement that the claimed invention would be obvious to one of ordinary skill in this art upon viewing Baddiley." Appellant properly assumed, in view of the express language of section 103, that the obviousness of his claimed invention would be tested as of "the time the invention was made." And since Baddiley was not even *in existence* at that time, it could hardly be said that his invention was obvious thereover at that time. Even assuming that appellant accepted as correct the contention which has now been given the force of law by this court in Foster, he certainly was under no obligation to raise arguments and produce evidence directed to issues under section 101(b) [sic], *since,* I repeat, *there was no rejection on that basis.* Insofar as appellant was concerned, his Rule 132 affidavit had removed Baddiley as a reference *for purposes of section 103,* and since section 102(b) was not involved in any rejection, he had satisfied the statutory conditions for patentibility [sic].

Now appellant learns that what seems to have been a section 103 rejection is here sufficient to raise the issue of loss of right to patent under section 102(b). If I may be permitted an ad hominem, this is truly learning the hard way. For this is one case in which it is painfully clear that the appealed rejection did not provide the applicant "with such information * * * as may be useful in judging

of the propriety of continuing the prosecution of his application," to which he is entitled under 35 U.S.C. 132. In addition, the present majority seems to have little regard for the jurisdictional limits of this court, in that it now decides an issue that was never presented below. I find nothing in sections 141 through 146 of Title 35 which could, even by the most imaginative lawyer, be interpreted to permit this court to decide an appeal on the basis of section 102(b) when the only rejection was for obviousness under section 103.

To me it is unconscionable that an applicant can now receive a rejection from the Patent Office on one statutory ground, and then, on appeal from that rejection, receive a wholly new rejection from this court which is based on an entirely different statutory ground. I would reverse.

In the Matter of the Application of Hassler

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

No. 7318 Decided July 1, 1965

Appeal from the United States Patent Office

MARTIN, Judge.

The issues we must determine in this appeal are whether a newspaper article reporting progress of experiments by appellant and his coworkers is available as a reference, and if so, whether it, coupled with knowledge of the art either as generally known or as shown by certain patents, is sufficient to make the presently claimed invention obvious to one of ordinary skill in the art.

A newspaper article titled "Bulk Leaf Curing Method Ready for Farm Testing," appeared in "The News and Observer," Raleigh, North Carolina, on November 10, 1958. The article reports the results of a method of bulk curing tobacco regarded as "so promising that private manufacturers have now been encouraged to consider the development of commercial equipment and to aid in farm-scale testing." The method is stated to have been developed by agricultural engineers with the "N. C. Agricultural Experiment Station and USDA," and was "tested at the Oxford Research Station this summer" under a "cooperative tobacco curing program" headed by appellant, Dr. Francis J. Hassler.

Nineteen months later, on June 13, 1960, appellant Francis J. Hassler filed an application serial No. 35,499 for "Method and Apparatus for Bulk Curing Tobacco." A subsequent requirement for division by the Patent Office led to the instant application, serial No. 164,789, filed

January 8, 1962, titled the same as the parent, but the claims of which are restricted to the apparatus alone. As will be seen in greater detail below, the newspaper article disclosure corresponds in great part to the apparatus now claimed.

Appellant, in his main and reply brief, has taken two approaches to the article disclosure. First, it is urged that the article "merely identifies a bulk curing process which is being tested." Appellant notes that the Patent Office admits the article does not disclose all the claimed structure, nor does it disclose the nature of the curing process. It is argued that the article is merely "a disclosure of Dr. Hassler's early experimental work" which is now being used to preclude the patenting of "the ultimate commercial reality of those experiments." Appellant reasons that:

> "Since the News and Observer article was published at a time when the invention was in the experimental stage, appellant is entitled to the 'hospitality' accorded by law and the disclosure of the article should not be construed strictly against him."

In view of the fact that the article does not disclose all the claimed structure, appellant states that The News and Observer article "clearly does not constitute a statutory bar."

Appellant takes a second position, in major part relying on In re Palmquist, 51 CCPA 831, 319 F.2d 552, 138 USPQ 234, to the effect that the "board's rejection of the present claims is clearly based upon 35 USC 103," but "since the News and Observer article clearly is not prior to applicant's first date of invention, it is not a proper reference to be utilized in determining obviousness under 103."

The solicitor's brief points out that there is no evidence of record showing that the claimed invention had been *completed* prior to the publication of The News and

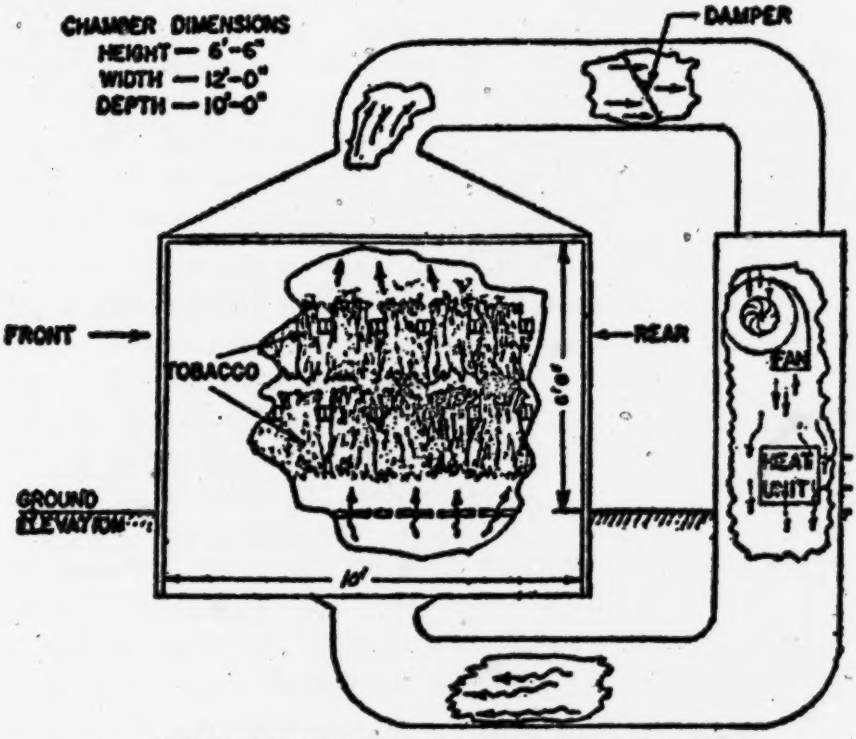
Observer article, thus the reliance on Palmquist was not well founded. The solicitor also points out that the two lines of argument are inconsistent, the appellant arguing on the one hand that the invention *had not been completed* prior to the article which therefore cannot be a barring anticipatory disclosure, and, on the other hand, that the invention *had been completed* prior to the publication, and in view of Palmquist the article was not an available reference for a section 103 rejection. Appellant's reply brief is devoted almost entirely to the argument based on Palmquist, urging that since The News and Observer article is a report of appellant's own invention it is both absurd and unnecessary to require him to swear behind it, citing M.P.E.P. 715.01(c).

We think the contradiction between the two lines of appellant's argument is more apparent than real. As we see it, appellant is arguing that The News and Observer article is not a complete disclosure, and so much of the invention as was disclosed therein was made prior to the publication thereof. Nevertheless, the line of argument concerning the unavailability of The News and Observer article has been rendered moot by our recent decision in In re Foster, 52 CCPA ——, —— F.2d ——, 145 USPQ 166, in which that aspect of In re Palmquist relied on by appellant for support was explicitly overruled.

We agree with the board's holding that The News and Observer article is a valid reference under 35 USC 102(b) *for what is disclosed therein,* since it was available to the public for more than a year prior to applicant's filing date. In re Ruscetta, 45 CCPA 968, 255 F.2d 687, 118 USPQ 101; In re Foster, *supra.* The publication is not removed as a reference merely because it discloses appellant's own invention, or an early stage of that invention, and the publication, having been available to the public for more than a year, may not be overcome by a showing of invention prior to the publication date. The question then is to

determine what is disclosed therein and whether that disclosure, taken with prior art, renders the claimed invention obvious to one of ordinary skill in the art.

The News and Observer article consists of text, three photographs, and a diagram, the last being reproduced here:



EXPERIMENTAL MODEL OF BULK CURING CHAMBER.

The pertinent part of the article text states:

"Bulk Leaf Curing Method Ready For Farm Testing"

"By Tom Byrd."

* * *

"More Uniform Leaf"

"'It [the method] also has the potential for producing a more uniform leaf,' Dr. Hassler said, 'which will make grading easier.'"

"A special barn is required to bulk-cure tobacco. However, the leaf is prepared for market the same way as conventionally-cured tobacco."

* * *

"In this new bulk-curing process tobacco is placed in frames by the armful, rather than tied on sticks three or four leaves at a time."

"Two men can frame the tobacco and place it in the barn as rapidly as at least four men can prime it from the field. Under present barning methods, about 10 barn hands are needed to keep up with four primers."

"Laboratory tests show there are no significant chemical differences in the bulk-cured and conventionally-cured tobacco. Representative samples of tobacco bulk-cured at the Oxford station last summer averaged $62 per hundred on the open market."

* * *

"New Approach"

* * *

" 'Throughout our work,' Dr. Hassler continued, 'we have recognized that the present curing method is a major factor in characterizing our flue-cured tobacco. Therefore, in the research and development of this new process we have been very careful to compare those qualities that characterize our flue-cured tobacco.' "

The first photograph shows a worker placing tobacco leaves in a trough-like loading bin. A horizontal bar having numerous long spikes extending downward therefrom is disposed above the tobacco in the loading bin. The caption states:

"Bill Johnson places tobacco into frames for curing. Spikes at top of frame are pushed through tobacco to hold it in place."

The second photograph shows two workers lifting the special "frame" which holds the tobacco, and is captioned:

"Wiley Henson (left) and Rupert Watkins move a frame of tobacco from loading racks to curing barn. Frame holds 10-12 sticks."

The third photograph shows the interior of the curing chamber. Two tiers of the special frames which hold the tobacco are shown therein, one end of each frame being supported by posts in the center of the barn, while the other end of each frame is apparently supported on the walls visible at the edges of the photo. The caption states:

> "INTERIOR OF BARN used for bulk curing is shown here. Hot air moves up through the floor and through the frames of tobacco. Two-thirds as much tobacco could be cured in this chamber as in a 16 x 16 foot barn."

The disclosure of the appealed application will be readily apparent from certain of the drawings:

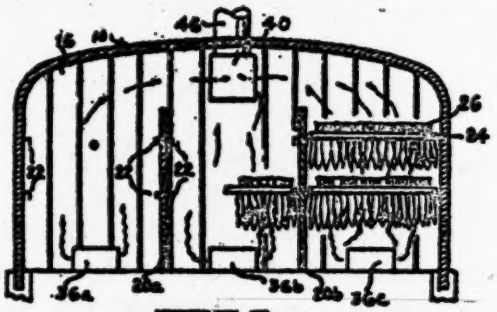


FIG. 3

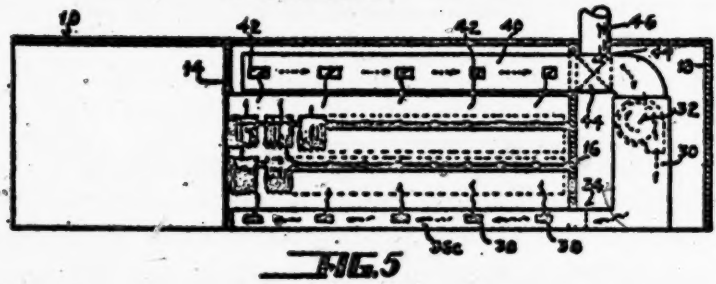


FIG. 5

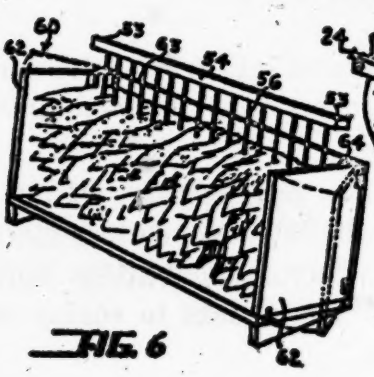


FIG. 6

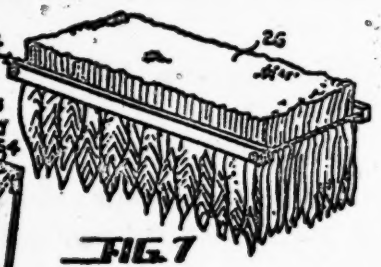


FIG. 7

Fig. 5 shows a longitudinal section view of a curing barn, and Fig. 3 shows a cross-sectional view through the drying chamber portion. Referring to Fig. 5, furnace 30 heats air which is moved from the furnace room (delineated by the area between right end wall 18 and partition 16) by a blower 32 through duct 36c into the drying chamber (delineated by the area between left end wall 14 and partition 16). Hot air leaving ports 38 passes through the tobacco 26 (Fig. 3) racked in special frames 24. Dimensions of the frames, barn partitioning (i.e. consider Fig. 3, partitions 20a, 20b, and Fig. 5, walls 14, 16), and close leaf packing are "* * * such as to force the circulated air to flow between the bulked tobacco leaves." The air then exits via upper duct 40. Element 44 is a damper and outlet duct 46 communicates to the outside atmosphere. By adjustment of the damper, varying amounts of fresh air may be admitted to the heating system, and, if desired, "* * * duct 46 may be closed, such that the air within the system is recirculated without addition of fresh air." A particular cycle of temperature and humidity throughout a 3-stage drying process is disclosed.

The apparatus used in the process of loading the frames or racks with tobacco leaves to be dried is illustrated in Figs. 6 and 7. The loading bin has an open top and open side. Tobacco leaves are placed butt end first into the bin and a frame or rack side-member 54 is pressed downwardly to force the spikes 56 through the tobacco leaves. A second side-member (not shown) receives the spikes, and the two side-members are fastened together by end rods (Fig. 7). The loading bin end panels 62 (Fig. 6) are then swung away, and the completed frame or rack of tobacco is lifted out and positioned in the curing barn, being slid thereinto on rails 22 (Fig. 3), mounted on the partitions 20a, and 20b, and the sidewalls.

Figs. 6 and 7 correspond to the first two photographs of The News and Observer article, with the exception that

workers are seen in the photos manipulating the bin and frame or rack of tobacco.

Appellant's claim 9, representative of claims 9-15 on appeal, reads as follows except that the breakdown, numbering and emphasis are ours:

9. Apparatus for bulk curing tobacco leaves comprising

A. a plurality of *tobacco leaf supporting racks* [also called "frames" by appellant], each of said racks including sections movable apart to receive a batch of tobacco leaves in bulk form with the flat surfaces thereof disposed generally in one direction and with at least a substantial portion of the flat surfaces of the leaves generally parallel and movable together to support the batch of leaves in a compressed state, the sections of each rack when together including means for continuously peripherally confining the batch of leaves along a pair of straight parallel first sides and a pair of straight parallel second sides extending perpendicular to said first sides and spike means extending within the peripheral confining means between a pair of parallel sides thereof in piercing relation to the batch of leaves in a direction generally perpendicular to the parallel flat surfaces thereof so as to provide interior support for the leaves while permitting flow of air between the leaves within the confining means in the direction of disposition of the flat surfaces thereof,

B. *a barn structure* for supporting said plurality of racks when the sections thereof are together in supporting relation to respective batches of tobacco leaves, said barn structure including

1. spaced pairs of elongated horizontally extending *rail means,*

each pair of rail means providing substantially continuous upwardly facing supporting surfaces disposed generally in the same horizontal plane, said rail means being included within said barn structure with the supporting surfaces of each pair of rail means spaced apart a distance sufficient to engage and support a group of said racks in side-by-side relation with the first sides of the peripheral confining means of said racks extending horizontally adjacent said supporting surfaces and with adjacent second sides of adjacent racks extending horizontally therebetween in substantially abutting relation,

2. said barn structure including *vertical wall means* extending upwardly from *a floor and a roof supported by said vertical wall* means above said floor, said rail means being disposed within said vertical wall means at positions between said floor and said roof, said *vertical wall means defining with said roof and said floor upper and lower air spaces* disposed respectively above and below said rail means,

said vertical wall means including *closable door means* adjacent one end of said pairs of rail means openable to provide access completely horizontally across the associatd supporting surfaces to permit said groups of leaf supporting racks to be moved into said side-by-side relation by horizontal sliding movement along the associated supporting surfaces, said barn structure and the vertical wall means thereof with said door means closed confining direct vertical communication between said air spaces solely to the rack occupying spaces defined between the pairs of supporting surfaces of each of said pair of rail means,

3. *fan means* having a suction side and a pressure side for creating a forced flow of air,

4. *means* for communicating the pressure and suction sides of said fan means with said air spaces respectively so as *to establish a circulatory path of air flow* including generally vertical flow of air through said rack occupying air spaces,

5. *means for heating* the air flowing in said path,

6. and *means for introducing* controlled amounts of atmospheric air into *and exhausting controlled amounts of air* from the air flowing in said path,

the capacity of said fan means, said heating means and said air introducing and exhausting means being such that sufficient air of a *desired temperature and moisture content* can be forced generally vertically through said rack occupying spaces to effect a yellowing of the leaves supported by said racks, a subsequent drying thereof, and a final ordering of the leaves.

Claim 10 depends from claim 9 and specifies two tiers of rail means to support the frames or racks of tobacco. Claim 11 also depends from claim 9 and specifies the two tiers of rails and a pair of inner partitions in the curing chamber. Claim 12 depends from claim 11 and additionally specifies walls defining a furnace room adjacent the curing chamber. Claim 13 depends from claim 9 and specifies a humidifier "for introducing a controlled amount of moisture" into the circulating air. Claims 14 and 15 are similar to claim 12, in independent form, with claim 15 additionally specifying separate dampers for each lower air duct. There are no allowed claims.

We deem it unnecessary to set forth any further analysis of how The News and Observer article was applied to the claims. It will be evident from comparison of the diagram reproduced above with the elements of the claim that there are but few claim elements lacking. Because some claim limitations are missing from the article, the examiner and

board evidently viewed the loss of right to involve the question of obviousness. Both appellant and the solicitor in their briefs similarly characterize that aspect of the issue. To supply the missing elements, the Board of Appeals has taken "judicial notice" of several elements and has also relied on secondary references.

In particular, the board took "judicial notice of dampers," and stated that it is "common practice in air conditioning systems to provide means for introducing * * * and exhausting controlled amounts of air from the system." The board also took judicial notice that it is common to have a separate furnace room in a building. The board relied on the following references:

Stevens et al.	2,752,096	June 26, 1956
Vickers	2,808,283	Oct. 1, 1957

Stevens et al. is directed to a tobacco curer employing the circulation of heated air. The apparatus disclosed comprises a small furnace placed on the floor in a conventional tobacco barn. Horizontal air outlet conduits extend from the top of the furnace to various parts of the barn. A second air conduit, containing several air inlets, is placed in the peak of the barn. That conduit extends downwardly at one end of the barn, along the floor through a blower and into the furnace. By means of this system, air is heated and circulated through the outlet conduits throughout the entire barn and may be returned by way of the inlet conduits.

The teaching in Stevens et al. relied on by the board pertains to the disclosure of a means for supplying moisture to the air, which means consists of a waterline terminating in a spray nozzle which is located in the air path between the furnace and the horizontal air outlet conduits. Stevens et al. states:

> "* * * The purpose of this construction is to introduce very moist air into the tobacco barn after the tobacco

has been cured. This restores enough moisture to the tobacco so that it may be handled without crumbling."

While Stevens et al. discloses using that humidifying device *after* the tobacco has been cured, we are here concerned with structure, not method. We do not see any difference in the "humidifier" means as called for in claim 13 and that shown in Stevens et al. Stevens et al. also quite clearly shows the humidifier in the same apparatus context, that of an air circulating tobacco curing apparatus. In view of that teaching of Stevens et al., it would be obvious to provide air humidifying means in conjunction with the tobacco curing apparatus claimed.

It was unnecessary to take judicial notice of dampers as recited in the claims since The News and Observer article shows damper means on the upper exhaust conduit. Further, Stevens et al. shows (in their Fig. 1) a T-junction in the air conduit leading from the peak of the barn down to the furnace. The T-junction leads a short distance through the barn wall to the outside atmosphere, and at the outer end thereof appears a conventional hinged flap-type closure. That conduit and hinged closure appears to be a type of conventional damper, and its function is well known.

Also we are in complete agreement with the board that providing doors for the curing chamber would be obvious; though not shown in The News and Observer article, such structure is inherent.

Vickers was cited for the purpose of showing a frame in which the tobacco leaves are impaled for hanging in a curing barn. The rejection alternatively relied on Vickers for that showing, in the event that the first two photographs of The News and Observer were not considered to show all the detailed structure claimed. Suffice it to say that the difference between Vickers' tobacco curing stick and that claimed is one of capacity. Vickers intends his tine-

type stick to replace the traditional stick without an increase in capacity of tobacco secured thereon. An increase in capacity is not reflected structurally in the claim, but in any event is clearly evident from the disclosure in The News and Observer, in which each frame is said to hold "10 to 12 sticks" of tobacco. Any details of a frame which would function as does that claimed, if not shown in The News and Observer article, are quite well supplied by equivalent structure in Vickers.

Viewing the record as a whole, we are satisfied that the board did not err in its application of the pertinent art to the claims. In view of the knowledge which one of ordinary skill in this art possesses, as evidenced by the patents to Vickers and Stevens et al., The News and Observer article would make the subject matter presently claimed entirely obvious. Since the claimed invention has been obvious to the public for more than a year prior to appellant's filing date, we hold appellant to have lost his right to patent under 35 USC 102(b). In re Foster, *supra*.

In view of the foregoing, the decision of the board is *affirmed*.

SMITH, Judge, concurring.

In my opinion, the publication in the *Raleigh News and Observer* on November 10, 1958, more than one year prior to appellant's filing date, is an enabling disclosure which so described the invention here claimed that one of ordinary skill in the tobacco flue-curing art can be said to have had possession of the invention at that time. The additional references cited are at best evidence of what one of ordinary skill in this art would be expected to know.

In Cohn v. United States Corset Co., 93 U.S. 366, 377 (1876), the Court stated the guiding principle which I think is applicable here:

> "* * * the evidence shows that the Johnson *specification, in connection with the known state of the art at the time when it was filed and published, was sufficient to enable one skilled in the art* of corset-making and in the use of the jacquard *to make the patented corset.* * * *" [Emphasis added.]

See also In re Sheppard, 52 CCPA 859, 339 F. 2d 238, 144 USPQ 42; In re LeGrice, 49 CCPA 1124, 301 F. 2d 929, 133 USPQ 365. Cf. In re Wenzel, 24 CCPA 1050, 88 F. 2d 501, 33 USPQ 30.

Appellant urges that since the publication describes his own experimental work, it is clear that his date of invention is earlier than the publication date. While this undoubtedly is true, no exceptions are provided under 102(b) when, as here, the invention was *described* in the printed publication.

Appellant urges that the publication should be "strictly construed" to the end that since the invention was in an experimental stage on the date of publication, appellant is entitled to the "hospitality" accorded by law to encourage experimentation and further development of an invention before an application is filed thereon.

Congress has seen fit to fix the time period for such "hospitality" at one year from the date of a publication describing the invention and we can do nothing about it except to review and compare the invention claimed and the invention described in the publication.

Appellant urges that when this is done,

> "There are two fundamental reasons why the News and Observer article does not meet such strict tests. First, the article does not clearly disclose all of the structural limitations set forth in the claims. Second, the article is completely lacking in any disclosure of how a complete structure *could be used to obtain the results alluded to.* So long as the article includes these deficiencies the invention has not been placed in the possession of the public, nor would one skilled in the art be enabled to make *and use* the structure or to practice the invention."

I have reviewed the *News and Observer* publication in view of appellant's position and have concluded that it does convey to one of ordinary skill in the tobacco flue-curing art a sufficient disclosure of the invention to permit it to be put into practical operation. Hence, it seems to me that it meets the requirements of a publication spelled out in In re LeGrice, *supra,* and the cases therein discussed.

I do not, therefore, regard this case as involving a rejection under 35 USC 103 and I agree fully with the statement in appellant's brief that:

> "* * * It can be stated unequivocally that if the present claims are held to be unpatentable, it is not because Dr. Hassler failed to make an invention, but solely because Dr. Hassler was not sufficiently diligent in filing his application."

To the extent the resolution of the issue here requires a determination of patentability under section 103, as the

majority seems to indicate, I would *reverse* for the reasons more fully elaborated in my dissenting opinion in In re Foster, 52 CCPA ——, —— F. 2d ——, 145 USPQ 166. However, it does not seem to me that this issue is here presented since the publication relied upon "describes" the claimed invention within the meaning of section 102(b) and the many decisions which have interpreted it. I therefore concur in the result reached but do so solely on this basis.

IN THE UNITED STATES PATENT OFFICE

Decision of Board of Appeals, May 29, 1962

Ex Parte Frederick C. Foster

Before Asp, Examiner-in-Chief, and Behrens and Marmelstein, Acting Examiner-in-Chief.

Marmelstein, Acting Examiner-in-Chief.

This is an appeal from the final rejection of claims 12, 13, 17, 18, 22, 23, 25, 26 and 28 and from the refusal of the Examiner to allow claims 29, 30, 32, 33, 34, 35, 36, 39 and 40 which were added after the final rejection. Claims 14, 16, 19, 20, 21, 24 and 27 stand withdrawn from further consideration under Rule 142(b) as not readable on the elected species. No claims have been allowed.

Claim 12 is illustrative and reads as follows:

> 12. A synthetic polymer selected from the group consisting of rubbery homopolymers of butadiene-1,3 and rubbery copolymers of butadiene-1,3 and styrene; said synthetic polymer being characterized by a *cis* 1,4-structure of at least 23% and a 1,2-structure not in excess of 15% of the polymeric butadiene present in the polymer.

The single reference relied on is:

Binder, "Ind. & Eng. Chem.," **46**, pages 1727 to 1730 (1954)

Reference added by us:

Greene	2,762,790	Sept. 11, 1956
		(filed Dec. 26, 1952)

The claimed invention relates to elastomeric rubbery polymers of butadiene and copolymers of butadiene and styrene based upon the fact that the polymers of the invention possess a substantially increased amount of *cis* 1,4- and a decreased amount of 1.2-structure. The polymers are said to have outstandingly good properties at low temperatures.

The Binder article is adequately described by the Examiner on pages 2 and 3 of his answer.

All the appealed claims have been rejected as unpatentable over the Binder article, the Examiner setting forth his position as follows:

> "Claims 12, 13, 17, 18, 22, 23, 25, 26, 28-30, 32-36, 39 and 40 are rejected as unpatentable over Binder which discloses butadiene polymers having a cis 1,4; trans 1,4; and 1,2 structural content substantially the same as that defined by the claims. For example, claims 12, 13, 29, 30, 34, 35, 36, 39 and 40 which read on a butadiene polymer having at least 23% cis 1,4 structure and not exceeding 15% 1,2 structure is unpatentable over the disclosure in Table V which discloses a butadiene polymer having 22.4% cis 1-4 and wherein 17.1% is of the 1,2- structure. Moreover, claims 22, 23, 25, 26 and 28 which read upon a butadiene polymer characterized by possessing a 100% cis 1,4 or 100% trans 1,4 structure are deemed unpatentable over the disclosure on page 1730 under conclusions. The Examiner is cognizant that the properties of the polymers defined by the claims differ from those disclosed by the reference; however, these differences are recognized as being differences of degree and not of kind. Lastly, it should be noted that the vulcanization of a polybutadiene is a conventional expedient apparent to those skilled in the art. Hence the patentability of claims 17 and 18, a by product of said vulcanization process, is dependent upon the patentability of claims 12 and 13 and accordingly, are subject to the rejection."

After full and careful consideration of the Binder article and all of appellant's arguments presented in his briefs and at the hearing together with the affidavits of record, we are of the opinion that the rejection of all the claims on the Binder reference should be sustained.

Binder teaches the desirability of obtaining a butadiene polymer having a high *cis*-1,4-configuration content and

therefore the claims to such products cannot be considered as defining patentable novelty. Although Binder does name a 100% *cis*-1,4 polybutadiene and therefore may be deemed to be a disclosure of said polymer, thus meeting the polymers defined by the appealed claims according to *In re* Von Bramer et al., 29 CCPA 1018, 1942 C. D. 462, 542 O. G. 183, 127 F. (2d) 149, we particularly consider the claims, calling for the polymers being of at least 23% *cis*-1,4 structure and not in excess of 15% 1,2-structure, to be unpatentable over Binder's disclosure of such polymers disclosed in Table V having a 22.4% *cis*-1,4 structure and wherein 17.1% is of the 1,2-structure.

For the purpose of establishing the criticality of the recited limitations in the claims on the content of *cis*-1,4- and 1,2-structures, affidavits have been filed for the purpose of showing that the differences between the claimed polymers and those disclosed by Binder are of kind rather than of degree as held by the Examiner.

As to the affidavits, the Examiner states that it is well known that natural rubber is of high *cis*-1,4 content and has the properties of low hysteresis, tensile strength, ultimate elongation and that the art is well aware that by increasing the amount of *cis*-1,4 content of a polybutadiene polymer, the properties of the synthetic polymer will resemble those of natural rubber. It is contended that because of the foregoing, the affidavits do not show that the claimed polymers have any properties that one skilled in the art would not expect them to possess. It is the Examiner's position that the result achieved by appellant does not represent a difference in kind over the prior art or *that the results are unforeseeable.*

We have examined the affidavits and do not think that they can be considered as effective in establishing criticality of appellant's polymers over those disclosed by Binder. Referring to the Johnson affidavit filed May 26, 1961, under item 16 it is stated that Johnson caused to be duplicated eleven different polymers and copolymers identified in the Binder article by the indicated designations. The one

closest to those claimed is the polymer designated 1140 which according to the reference has 22.4% *cis*-1,4- and 17.1% 1,2-structure. The other of the polymers are of various content of *cis*-1,4 structure less than 22.4% and farther removed from the claimed *cis*-1,4 structure content. As to the polymers other than 1140 of the references, it is indicated that the polymers are solid similarly to those of appellant whereas as to polymer 1140 it is shown that it was too fluid and sticky to test. It seems strange that as to the polymer nearest to those of the claims, appellant's reproduction produced a non-solid polymer whereas as to all the others of the reference that are reproduced and which are farther removed from those of the claims, solid polymers were obtained. There is also another more important objection to the 1140 polymer reproduced by appellant. The reproduced polymer shown as having 19.2% *cis*-1,4- and 19.1% 1,2-structure is even farther removed from those claimed. Under the circumstances we cannot accept appellant's showing as being a comparison of the closest polymers of those claimed and of the reference. We thus have not been convinced that there is a difference in kind and not of degree between the *cis*-1,4 polymers of 23% of the claims and the 22.4% of the reference. While appellant has achieved a particularly desirable product, we cannot agree that this product represents a difference in kind over the prior art, or that the results are unforeseeable.

We have taken note of the numerous publications, copies of which have been filed herein, but we cannot see that they serve to establish a difference in kind of the claimed polymers over those of the Binder reference. As to commercial success which is indicated by the publication exhibits, it is unnecessary to cite any decisions in support of the doctrine that commercial success is of no consideration when there is no doubt as to lack of invention over the prior art.

Claims 39 and 40 have been further rejected as not properly defining the alleged invention.

As to claim 39, the Examiner has held that the recitation ". . . not less than 2.3% . . ." is not adequately supported within the specification. We will not sustain the rejection as to this claim. We consider the disclosure of this lower limit of the 1,2 structure in Example 13 as adequate support therefor.

As to claim 40, the Examiner has held that there is no basis in the specification for terms such as "ionic catalyst" and "nonaqueous system." As to the remaining quoted expressions, they are not present in claim 40. As to "ionic catalyst," this term does not appear to have been used by appellant in describing the catalysts used in his process of producing the claimed polymers. Appellant's catalysts are "ionic" but he has disclosed a very limited number and kind thereof. We are of the opinion that the term in question is unsupported as to breadth thereof. As to "nonaqueous system," we agree with the Examiner that this term is too broad and insufficiently descriptive. In addition, the Examiner notes that claim 40 is improper inasmuch as product claims described by characteristics and product by process claims concurrently presented are inconsistent. Claim 29, the Examiner states, makes it more than apparent that the product can be described in ways other than by its mode of preparation. We will sustain this rejection as to claim 40.

The patent to Greene, the citation of which is given above and which has been added by us, discloses in column 1, lines 30 to 35, the polymerization of aliphatic conjugated diolefins, particularly 1,3-butadiene, to high molecular weight, solid, elastic polymers characterized by the presence of a predominant proportion of 1,4-linked, cis-configurational monomer units. Under Example 1, column 8, lines 47 to 56, the solid polybutadiene product is said to contain 80% 1,4-linked butadiene units of which 62.5% has the cis-configuration. This calculates to 50% of the polymer as of the *cis*-1,4-configuration. It is our opinion that all the appealed claims are unpatentable over the noted disclosures of the Greene patent and we therefore herewith

reject all the appealed claims on the Greene patent under the provisions of Rule 196(b).

As indicated above in connection with the rejection of claims 39 and 40 as not properly pointing out the invention, the Examiner has remarked that it is improper as being inconsistent for product claims to be described by characteristics and product by process claims presented concurrently. In addition we deem it necessary to point out that when product claims are drawn in terms of the process, even if proper as an exception to the general rule, critical steps of the process may not be omitted in the description of the process. Claims 30, 32, 33, 36 and 40 appear to depend for patentability upon process limitations or may be considered as product by process claims and it is clear that critical steps or limitations as to the conditions of the process have been omitted. *In re* McKee, 25 CCPA 1011; 1938 C. D. 425; 495 O. G. 711; 95 F. (2d) 267. Product claims depending for patentability on process should recite all necessary steps to obtain product. *Ex parte* Green, 69 USPQ 620. Under the provisions of Rule 196(b), we herewith enter a rejection of claims 30, 32, 33, 36 and 40 as being improper product by process claims in accordance with the foregoing.

The decision of the Examiner is affirmed. Rejections under the provisions of Rule 196(b) have been added.

Any request for rehearing or reconsideration or modification of this decision by the Board of Appeals based upon the same record must be filed within thirty days from the date of the decision. (Rule 197). Should appellant elect to have further prosecution before the Primary Examiner in response to the new rejection under Rule 196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire *sixty days* from the date of decision.

IN THE UNITED STATES PATENT OFFICE

Decision of Board of Appeals, September 17, 1962

Ex Parte Frederick C. Foster

On Reconsideration

Before Asp, Examiner-in-Chief, and Behrens and Marmelstein, Acting Examiners-in-Chief.

Marmelstein, Acting Examiner-in-Chief.

Appellant requests reconsideration of our decision of May 29, 1962 in which we affirmed the rejection of all the claims in the case and wherein we also entered new rejections under the provisions of Rule 196 (b).

With respect to the rejection of all the claims on the Greene patent upon which we rejected the claims under the provisions of Rule 196 (b), appellant has filed affidavits under the provisions of Rule 131 in order to antedate this patent and thereby to dispose of it as a reference. We have examined the Rule 131 affidavits and all the exhibits forming part thereof and find them acceptable to dispose of the Greene patent and we accordingly herewith withdraw the Greene patent as a reference against the appealed claims.

The affidavits under Rule 132 that have been filed against the Greene patent have not been considered, not only because this patent has been disposed of under Rule 131, but also and particularly because they can be of no pertinency under the facts of this case. The invention being claimed herein resides in a product and not in a process for the production thereof. The reference discloses the product and it is of no moment whether the disclosed methods for producing it are operative or not.

The Rule 132 affidavits filed with the request for reconsideration with respect to the rejection on the Binder reference have not been considered. The reconsideration requested must be upon the record. Rule 197.

We have reconsidered the rejection of the claims on the Binder reference and we remain of the opinion that it is

sound. The Binder reference does disclose a 100% *cis*-1,4 polybutadiene and also a composition (polymer 1140) very close to the 23% *cis*-1,4 claimed content polybutadiene. Appellant relies upon *In re LeGrice*, 49 CCPA ————; 301 F. (2d) 929; 133 USPQ 365, in arguing against the Binder reference. We have reviewed this case and find therein no basis to indicate that our holding of unpatentability of the claims on Binder is improper. We think that the instant case is similar to the facts in the case of Shell Development Co. v. Watson (citation in the quotation below) which the court in the LeGrice case said properly supported facts such as here involved. The following is quoted from the LeGrice case (page 377 USPQ citation):

> "In Shell Development Co. v. Watson, 149 F. Supp. 279, 113 USPQ 265, 268, affirmed 102 U. S. App. D. C. 297, 252 F. 2d 861, 116 USPQ 428, which the Patent Office further cites to support its position, the court relied on the Merck case and stated further:
>
> A clear description in a prior publication is all that is necessary under the law to bar a subsequent inventor from obtaining a patent on the identical thing. In other words, a prior publication, in order to defeat a patent, need only exhibit the thing claimed in such an intelligible manner as to *enable persons skilled in the art to which the invention is related, to comprehend* it. Defendant's refusal to grant the claim sought here based upon the Ring Index publication was proper for the Court holds that the name and the structural formula contained in the Ring Index publication constitutes a sufficient description to anticipate. Plaintiff's claim 13 is clearly described in the publication within the meaning of the statutory language. I find for the defendant. (Emphasis ours.)
>
> The court in the Shell case cited the Merck case as its authority. It is therefore in this light that we must construe the court's use of the word *comprehend*. So construed, the Shell case holds that the publication *in*

> *the light of the knowledge possessed by those skilled in the art* was sufficient to bar the grant of a patent. We do not find this to be inconsistent with our holding based on contrary facts in the case at bar."

As for the formal rejections of the claims, appellant has advanced nothing that convinces us that that part of our decision is in error.

Our decision has been reconsidered. The rejection of all the claims on the Greene patent is withdrawn. The decision in all other respects remains unchanged.